

Access DB# 79222**SEARCH REQUEST FORM**

Scientific and Technical Information Center

Requester's Full Name: Fred Taskin Examiner #: 64082 Date: 11/1/02
 Art Unit: 1713 Phone Number 308-296 Serial Number: 08/995950
 Mail Box and Bldg/Room Location: C13-8678 Results Format Preferred (circle): PAPER DISK E-MAIL

If more than one search is submitted, please prioritize searches in order of need.

Please provide a detailed statement of the search topic, and describe as specifically as possible the subject matter to be searched. Include the elected species or structures, keywords, synonyms, and registry numbers, and combine with the concept or utility of the invention. Define any terms that may have a special meaning. Give examples or relevant citations, authors, etc., if known. Please attach a copy of the cover sheet, pertinent claims, and abstract.

Title of Invention: _____

Inventors (please provide full names): _____

Earliest Priority Filing Date: _____

For Sequence Searches Only Please include all pertinent information (parent, child, divisional, or issued patent numbers) along with the appropriate serial number.

Handwritten: Ketogenic

Handwritten: 5,276,208

BEST AVAILABLE COPY

STAFF USE ONLY

Searcher: Mellgren
 Searcher Phone #: 8-4483
 Searcher Location: _____
 Date Searcher Picked Up: 11/1
 Date Completed: 11/1
 Searcher Prep & Review Time: 2
 Clerical Prep Time: _____
 Online Time: 30

Type of Search

NA Sequence (#) _____
 AA Sequence (#) _____
 Structure (#) _____
 Bibliographic ☒
 Litigation ☐
 Fulltext _____
 Patent Family _____
 Other _____

Vendors and cost where applicable

STN _____
 Dialog _____
 Questel/Orbit 4500
 Dr. Link _____
 Lexis/Nexis 4000
 Sequence Systems _____
 WWW/Internet _____
 Other (specify) _____

Current session 01/11/2002

(C) QUESTEL 1994

QUESTEL.ORBIT (TM) 1998

01/11/02 17*19*24

Last connection: 31/10/02 18*12*19

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- New Patent Citation Commands: easy & precise - INFO PATCITE
- USAPPS Reloaded: Pricing, see INFO USAPPS
- USPCL: US Patent Class Definition Look-up File - INFO USPCL
..FILE / ..INFO / ..GUIDE

Query/Command : FILE PLUSPAT

QUESTEL - Time in minutes : 2,16

The cost estimation below is based on Questel's
standard price list

	Estimated cost :	1.87 USD
Cost estimated for the last database search :		1.87 USD
Estimated total session cost :		1.87 USD

Selected file: PLUSPAT

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Comprehensive Worldwide Patents database

New Patent Citation Commands & FAM Citation Report - see INFO PATCITE

Last update of file: 2002/11/01 (YYYY/MM/DD) 2002-43/UP (basic update)

Search statement 1

Query/Command : US5276208/PN**** SS 1: Results 1**

Search statement 2

Query/Command : PRT FULL NONSTOP LEGALALL

1 / 1 PLUSPAT - ©QUESTEL-ORBIT - image

PN - US5276208 A 19940104 [US5276208]
TI - (A) Metallocenes containing ligands of 2-substituted indenyl derivatives, process for their preparation, and their use as catalysts
PA - (A) HOECHST AG (DE)
IN - (A) WINTER ANDREAS (DE); ANTBERG MARTIN (DE); SPALECK WALTER (DE); ROHRMANN JUERGEN (DE); DOLLE VOLKER (DE)
AP - US78936191 19911108 [1991US-0789361]
PR - DE4035884 19901112 [1990DE-4035884]
IC - (A) C07F-007/28 C07F-009/00 C07F-011/00
EC - C08F-010/00 C08F-004:62R2B4
C07F-007/08C4D
C07F-017/00
ICO - M08F-004/62R2B4
M08F-004/62R8
M08F-110/06 &MWDN &V
PCL - ORIGINAL (O) : 556053000; CROSS-REFERENCE (X) : 502117000 502152000
526129000 526160000 526943000 556009000 556011000 556014000 556019000
556021000 556022000 556043000 556058000
DT - Corresponding document
CT - US4769510; US4871705; EP0344887; DE3826075
STG - (A) United States patent
AB - The novel metallocenes of the formula I <IMAGE> (I) in which, preferably, M1 is Zr or Hf, R1 and R2 are alkyl or halogen, R3 and R4 are hydrogen, R5 and R6 are alkyl or haloalkyl, -(CR8R9)m-R7-(CR8R9)n- is a single- or multi-membered chain in which R7 may also be a (substituted) hetero atom, m+n is zero or 1, and R10 is hydrogen, form, together with aluminoxanes as cocatalysts, a very effective catalyst system for the preparation of polyolefins of high stereospecificity and high melting point.

1/1 LGST - ©LEGSTAT

PN - US 5276208 [US5276208]

AP - US 789361/91 19911108 [1991US-0789361]

DT - US-P

ACT - 19911108 US/AE-A
APPLICATION DATA (PATENT)
US 789361/91 19911108 [1991US-0789361]

19911108 US/AS02
ASSIGNMENT OF ASSIGNOR'S INTEREST
HOECHST AKTIENGESELLSCHAFT, A CORP. OF FED. REP. OF GERMANY
D-6230 FRANKFURT AM * WINTER, ANDREAS : 19911008; ANTBERG, MARTIN
: 19911008; SPALECK, WALTER : 19911008; ROHRMANN, JURGEN : 19911008;
DOLLE, : 19911008

19940104 US/A
PATENT

19980317 US/RF
REISSUE APPLICATION FILED
970717

19980407 US/RF
REISSUE APPLICATION FILED
970717

UP - 1999-11

1 / 1 CRXX - ©CLAIMS/RRX

PN - 5,276,208 A 19940104 [US5276208]
PA - Hoechst AG DE
ACT - 19970717 REISSUE REQUESTED
ISSUE DATE OF O.G.: 19980317
REISSUE REQUEST NUMBER: 08/895909
EXAMINATION GROUP RESPONSIBLE FOR REISSUEPROCESS: 1621

Reissue Patent Number:

19970717 REISSUE REQUESTED
ISSUE DATE OF O.G.: 19980407
REISSUE REQUEST NUMBER: 08/895950
EXAMINATION GROUP RESPONSIBLE FOR REISSUEPROCESS: 1505

Reissue Patent Number:

19980925 REASSIGNED
ASSIGNMENT OF ASSIGNORS INTEREST

Assignor: HOECHST AKTIENGESELLSCHAFT DATE SIGNED: 07/10/1998

Assignee: TARGOR GMBH RHEINSTR. 4G MAINZ GERMANY D-551

Reel 009453/Frame 0441

Contact: CONNOLLY AND HUTZ ASHLEY I. PEZZNER P.O. BOX 2207
WILMINGTON, DE 19899

1 / 3 PAST - ©Thomson Derwent

AN - 200123-001356
PN - 5276208 A [US5276208]
OG - 2001-06-05
ACT - REISSUE PATENT
RL - USRE37208

2 / 3 PAST - ©Thomson Derwent

AN - 199814-001258
PN - 5276208 A [US5276208]
OG - 1998-04-07
ACT - REISSUE APPLICATION FILED

3 / 3 PAST - ©Thomson Derwent

AN - 199811-001238
PN - 5276208 A [US5276208]
OG - 1998-03-17
ACT - REISSUE APPLICATION FILED

Query/Command : FILE INPADOC

PLUSPAT - Time in minutes : 7,39
The cost estimation below is based on Questel's
standard price list

Estimated cost :	16.25 USD
Records displayed and billed :	1
Estimated cost :	1.10 USD
Cost estimated for the last database search :	17.35 USD
Estimated total session cost :	19.22 USD

LGST - Time in minutes : 0,31
The cost estimation below is based on Questel's
standard price list

Estimated cost :	0.34 USD
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CRXX - Time in minutes : 0,27
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standard price list

Estimated cost :	0.40 USD
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Estimated cost :	5.00 USD
Cost estimated for the last database search :	5.40 USD
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PAST - Time in minutes : 0,39
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standard price list

Estimated cost :	0.77 USD
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Estimated cost :	16.83 USD
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LITA - Time in minutes : 0,08
The cost estimation below is based on Questel's
standard price list

Estimated cost :	0.15 USD
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Cost estimated for the last database search : 0.15 USD
Estimated total session cost : 43.28 USD

Selected file: INPADOC

You are now connected to INPADOC
Covers 1968/1973 thru weekly updates (2002-43)
For information on content, ..INFO INPD.

Search statement 1

Query/Command : FAM US5276208/PN

1 Patent Groups

**** SS 1: Results 21**

Search statement 2

Query/Command : FAMSTATE NONSTOP

1 / 21 INPADOC - ©INPADOC

PN - AT 165832 E 19980515 [ATE165832]
TI - VERFAHREN ZUR HERSTELLUNG EINES OLEFINPOLYMERS UNTER
VERWENDUNG VON METALLOCENEN MIT SPEZIELL SUBSTITUIERTEN
INDENYLLIGANDEN
IN - WINTER ANDREAS DR [DE]; KUEBER FRANK DR [DE]; SPALECK WALTER DR
[DE]; RIEPL HERBERT [DE]; HERRMANN WOLFGANG ANTON PROF D [DE];
DOLLE VOLKER DR [DE]; ROHRMANN JUERGEN DR [DE]
PA - TARGOR GMBH [DE]
AP - AT 93112056/93-EP 19930728 [1993EP-0112056]
PR - DE 4225649/92-A 19920803 [1992DE-4225649]
IC - C07F-017/00; C08F-010/00; C08F-004/642; C08F-004/76

1 / 2 LEGALI - ©LEGSTAT

PN - AT 165832 [ATE165832]
DT - AT-R
ACTE - 19980515 AT/REF-P
CORRESPONDS TO EP-PATENT
(EP 582194 19980506 [EP-582194])
UP - 1998-21

2 / 2 LEGALI - ©LEGSTAT

PN - EP 582194 [EP-582194]
AP - EP 93112056/93 19930728 [1993EP-0112056]
DT - EP-P

ACTE - 19930728 EP/AE-A
EP-APPLICATION
EP 93112056/93 19930728 [1993EP-0112056]

19940209 EP/AK-A1 [+]
DESIGNATED CONTRACTING STATES IN AN APPLICATION WITH SEARCH
REPORT:
AT BE CH DE ES FR GB IT LI LU NL SE

19940209 EP/A1 [+]
PUBLICATION OF APPLICATION WITH SEARCH REPORT

19940608 EP/17P [+]
REQUEST FOR EXAMINATION FILED
940414

19970108 EP/17Q [+]
FIRST EXAMINATION REPORT
961120

19971210 EP/RBV [+]
DESIGNATED CONTRACTING STATES (CORRECTION):
AT BE DE ES FR GB IT NL SE

19980304 EP/RAP1
APPLICANT REASSIGNMENT (CORRECTION)
TARGOR GMBH

19980506 EP/AK-B1 [+]
DESIGNATED CONTRACTING STATES MENTIONED IN A PATENT
SPECIFICATION:
AT BE DE ES FR GB IT NL SE

19980506 EP/B1 [+]
PATENT SPECIFICATION

19980506 EP/REF-R [+]
IN AUSTRIA REGISTERED AS:
(AT 165832 19980515 [ATE165832])

19980610 EP/GBT [+]
GB: TRANSLATION OF EP PATENT FILED (GB SECTION 77(6)(A)/1977)
980519

19980610 EP/REF-P
CORRESPONDS TO:
(DE 59308494 19980610 [DE59308494])

19980616 EP/REG; ES/FG2A
ES: DEFINITIVE PROTECTION
2114978T3
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19980702 EP/ITF [+]
IT: TRANSLATION FOR A EP PATENT FILED
ING. C. GREGORJ S.P.A.

19981002 EP/ET [+]
FR: TRANSLATION FILED

19990428 EP/26N [+]
NO OPPOSITION FILED

20020101 EP/REG; GB/IF02 [+]
GB: EUROPEAN PATENT IN FORCE AS OF 2002-01-01
<GB>

UP - 2002-17

2 / 21 INPADOC - ©INPADOC

PN - AU 87760/91 A1 19920514 [AU9187760]
TI - METALLOCENES CONTAINING LIGANDS OF 2-SUBSTITUTED INDENYL
DERIVATIVES, PROCESS FOR THEIR PREPARATION, AND THEIR USE AS
CATALYSTS
IN - WINTER ANDREAS; ANTBERG MARTIN; SPALECK WALTER; ROHRMANN
JURGEN; DOLLE VOLKER
PA - HOECHST AG
AP - AU 87760/91-A 19911111 [1991AU-0087760]
PR - DE 4035884/90-A 19901112 [1990DE-4035884]
IC - C07F-017/00

3 / 21 INPADOC - ©INPADOC

PN - AU 640287 B2 19930819 [AU-640287]
TI - METALLOCENES CONTAINING LIGANDS OF 2-SUBSTITUTED INDENYL
DERIVATIVES, PROCESS FOR THEIR PREPARATION, AND THEIR USE AS
CATALYSTS
IN - WINTER ANDREAS; ANTBERG MARTIN; SPALECK WALTER; ROHRMANN
JURGEN; DOLLE VOLKER
PA - HOECHST AG
AP - AU 87760/91-A 19911111 [1991AU-0087760]
PR - DE 4035884/90-A 19901112 [1990DE-4035884]
IC - C07F-017/00

4 / 21 INPADOC - ©INPADOC

PN - DE 59107926 C0 19960718 [DE59107926]
TI - METALLOCENE MIT LIGANDEN AUS 2-SUBSTITUIERTEN
INDENYLDERIVATEN, VERFAHREN ZU IHRER HERSTELLUNG UND IHRE
VERWENDUNG ALS KATALYSATOREN
IN - WINTER ANDREAS DR [DE]; ANTBERG MARTIN DR [DE]; SPALECK WALTER
DR [DE]; ROHRMANN JUERGEN DR [DE]; DOLLE VOLKER DR [DE]
PA - HOECHST AG [DE]
AP - DE 59107926/91-A 19911101 [1991DE-5007926]
PR - DE 59107926/91-A 19911101 [1991DE-5007926]
DE 4035884/90-A 19901112 [1990DE-4035884]
IC - C07F-017/00; C08F-004/602

1 / 2 LEGALI - ©LEGSTAT

PN - DE 59107926 [DE59107926]
DT - DE-P
ACTE - 19960718 DE/REF-P
CORRESPONDS TO
(EP 485821 19960718 [EP-485821])
19970710 DE/8364 [+]
NO OPPOSITION DURING TERM OF OPPOSITION
UP - 1997-28

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PN - EP 485821 [EP-485821]
AP - EP 91118680/91 19911101 [1991EP-0118680]
DT - EP-P
ACTE - 19911101 EP/AE-A
EP-APPLICATION
EP 91118680/91 19911101 [1991EP-0118680]
19920520 EP/AK-A1 [+]
DESIGNATED CONTRACTING STATES IN AN APPLICATION WITH SEARCH
REPORT:
BE DE ES FR GB IT NL
19920520 EP/A1 [+]
PUBLICATION OF APPLICATION WITH SEARCH REPORT
19920902 EP/17P [+]
REQUEST FOR EXAMINATION FILED
920701
19940727 EP/17Q [+]
FIRST EXAMINATION REPORT
940613

19960612 EP/AK-B1 [+]
DESIGNATED CONTRACTING STATES MENTIONED IN A PATENT
SPECIFICATION:
BE DE ES FR GB IT NL

19960612 EP/B1 [+]
PATENT SPECIFICATION

19960718 EP/REF-P
CORRESPONDS TO:
(DE 59107926 19960718 [DE59107926])

19960813 EP/ITF [+]
IT: TRANSLATION FOR A EP PATENT FILED
ING. C. GREGORJ S.P.A.

19960925 EP/GBT [+]
GB: TRANSLATION OF EP PATENT FILED (GB SECTION 77(6)(A)/1977)
960829

19960927 EP/ET [+]
FR: TRANSLATION FILED

19961016 EP/REG; ES/FG2A
ES: DEFINITIVE PROTECTION
2090209T3
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19961116 EP/REG; ES/FG2A
ES: DEFINITIVE PROTECTION
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19970604 EP/26N [+]
NO OPPOSITION FILED

20020101 EP/REG; GB/IF02 [+]
GB: EUROPEAN PATENT IN FORCE AS OF 2002-01-01
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UP - 2002-17

5 / 21 INPADOC - ©INPADOC

PN - DE 59308494 C0 19980610 [DE59308494]
TI - VERFAHREN ZUR HERSTELLUNG EINES OLEFINPOLYMERS UNTER
VERWENDUNG VON METALLOCENEN MIT SPEZIELL SUBSTITUIERTEN
INDENYLLIGANDEN
IN - WINTER ANDREAS DR [DE]; KUEBER FRANK DR [DE]; SPALECK WALTER DR
[DE]; RIEPL HERBERT [DE]; HERRMANN WOLFGANG ANTON PROF D [DE];
DOLLE VOLKER DR [DE]; ROHRMANN JUERGEN DR [DE]
PA - TARGOR GMBH [DE]
AP - DE 59308494/93-A 19930728 [1993DE-5008494]
PR - DE 59308494/93-A 19930728 [1993DE-5008494]
DE 4225649/92-A 19920803 [1992DE-4225649]
IC - C07F-017/00; C08F-010/00; C08F-004/642; C08F-004/76

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PN - DE 59308494 [DE59308494]
DT - DE-P
ACTE - 19980610 DE/REF-P
CORRESPONDS TO
(EP 582194 19980610 [EP-582194])

19990602 DE/8364 [+]
NO OPPOSITION DURING TERM OF OPPOSITION

20011018 DE/8327
CHANGE IN THE PERSON/NAME/ADDRESS OF THE PATENT OWNER
BASELL POLYPROPYLEN GMBH, 55116 MAINZ, DE
UP - 2001-42

2 / 2 LEGALI - ©LEGSTAT

PN - EP 582194 [EP-582194]
AP - EP 93112056/93 19930728 [1993EP-0112056]
DT - EP-P
ACTE - 19930728 EP/AE-A
EP-APPLICATION
EP 93112056/93 19930728 [1993EP-0112056]

19940209 EP/AK-A1 [+]
DESIGNATED CONTRACTING STATES IN AN APPLICATION WITH SEARCH
REPORT:
AT BE CH DE ES FR GB IT LI LU NL SE

19940209 EP/A1 [+]
PUBLICATION OF APPLICATION WITH SEARCH REPORT

19940608 EP/17P [+]
REQUEST FOR EXAMINATION FILED

940414

19970108 EP/17Q [+]
FIRST EXAMINATION REPORT
961120

19971210 EP/RBV [+]
DESIGNATED CONTRACTING STATES (CORRECTION):
AT BE DE ES FR GB IT NL SE

19980304 EP/RAP1
APPLICANT REASSIGNMENT (CORRECTION)
TARGOR GMBH

19980506 EP/AK-B1 [+]
DESIGNATED CONTRACTING STATES MENTIONED IN A PATENT
SPECIFICATION:
AT BE DE ES FR GB IT NL SE

19980506 EP/B1 [+]
PATENT SPECIFICATION

19980506 EP/REF-R [+]
IN AUSTRIA REGISTERED AS:
(AT 165832 19980515 [ATE165832])

19980610 EP/GBT [+]
GB: TRANSLATION OF EP PATENT FILED (GB SECTION 77(6)(A)/1977)
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19980610 EP/REF-P
CORRESPONDS TO:
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19980616 EP/REG; ES/FG2A
ES: DEFINITIVE PROTECTION
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IT: TRANSLATION FOR A EP PATENT FILED
ING. C. GREGORJ S.P.A.

19981002 EP/ET [+]
FR: TRANSLATION FILED

19990428 EP/26N [+]
NO OPPOSITION FILED

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UP - 2002-17

6 / 21 INPADOC - ©INPADOC

PN - EP 485821 A1 19920520 [EP-485821]
TI - METALLOCENES WITH 2-SUBSTITUTED INDENYL-DERIVATES AS LIGANDS,
PROCESS FOR THEIR PREPARATION AND THEIR USE AS CATALYSTS
LA - D; GER
IN - WINTER ANDREAS DR [DE]; ANTBERG MARTIN DR [DE]; SPALECK WALTER
DR [DE]; ROHRMANN JUERGEN DR [DE]; DOLLE VOLKER DR [DE]
PA - HOECHST AG [DE]
AP - EP 91118680/91-A 19911101 [1991EP-0118680]
PR - DE 4035884/90-A 19901112 [1990DE-4035884]
IC - C07F-017/00; C08F-004/602
DS - BE* DE* ES* FR* GB* IT* NL*

1 / 2 LEGALI - ©LEGSTAT

PN - DE 59107926 [DE59107926]
DT - DE-P
ACTE - 19960718 DE/REF-P
CORRESPONDS TO
(EP 485821 19960718 [EP-485821])

19970710 DE/8364 [+]
NO OPPOSITION DURING TERM OF OPPOSITION
UP - 1997-28

2 / 2 LEGALI - ©LEGSTAT

PN - EP 485821 [EP-485821]
AP - EP 91118680/91 19911101 [1991EP-0118680]
DT - EP-P
ACTE - 19911101 EP/AE-A
EP-APPLICATION
EP 91118680/91 19911101 [1991EP-0118680]

19920520 EP/AK-A1 [+]
DESIGNATED CONTRACTING STATES IN AN APPLICATION WITH SEARCH
REPORT:
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19920902 EP/17P [+]
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FIRST EXAMINATION REPORT

940613

19960612 EP/AK-B1 [+]
DESIGNATED CONTRACTING STATES MENTIONED IN A PATENT
SPECIFICATION:
BE DE ES FR GB IT NL

19960612 EP/B1 [+]
PATENT SPECIFICATION

19960718 EP/REF-P
CORRESPONDS TO:
(DE 59107926 19960718 [DE59107926])

19960813 EP/ITF [+]
IT: TRANSLATION FOR A EP PATENT FILED
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19960925 EP/GBT [+]
GB: TRANSLATION OF EP PATENT FILED (GB SECTION 77(6)(A)/1977)
960829

19960927 EP/ET [+]
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19961016 EP/REG; ES/FG2A
ES: DEFINITIVE PROTECTION
2090209T3
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19961116 EP/REG; ES/FG2A
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19970604 EP/26N [+]
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20020101 EP/REG; GB/IF02 [+]
GB: EUROPEAN PATENT IN FORCE AS OF 2002-01-01
<GB>

UP - 2002-17

7 / 21 INPADOC - ©INPADOC

PN - EP 582194 A1 19940209 [EP-582194]
TI - PROCESS FOR THE PREPARATION OF POLYMERS USING METALLOCENES
WITH SPECIFICALLY SUBSTITUTED INDENYL LIGANDS
LA - D; GER
IN - WINTER ANDREAS DR [DE]; KUEBER FRANK DR [DE]; SPALECK WALTER DR
[DE]; RIEPL HERBERT [DE]; HERRMANN WOLFGANG ANTON PROF D [DE];
DOLLE VOLKER DR [DE]; ROHRMANN JUERGEN DR [DE]
PA - HOECHST AG [DE]
AP - EP 93112056/93-A 19930728 [1993EP-0112056]
PR - DE 4225649/92-A 19920803 [1992DE-4225649]
IC - C07F-017/00; C08F-010/00; C08F-004/642; C08F-004/76
DS - AT* BE* CH* DE* ES* FR* GB* IT* LI* LU* NL* SE*

1 / 3 LEGALI - ©LEGSTAT

PN - DE 59308494 [DE59308494]
DT - DE-P
ACTE - 19980610 DE/REF-P
CORRESPONDS TO
(EP 582194 19980610 [EP-582194])

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20011018 DE/8327
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UP - 2001-42

2 / 3 LEGALI - ©LEGSTAT

PN - AT 165832 [ATE165832]
DT - AT-R
ACTE - 19980515 AT/REF-P
CORRESPONDS TO EP-PATENT
(EP 582194 19980506 [EP-582194])
UP - 1998-21

3 / 3 LEGALI - ©LEGSTAT

PN - EP 582194 [EP-582194]
AP - EP 93112056/93 19930728 [1993EP-0112056]
DT - EP-P
ACTE - 19930728 EP/AE-A
EP-APPLICATION

EP 93112056/93 19930728 [1993EP-0112056]

19940209 EP/AK-A1 [+]
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19980506 EP/AK-B1 [+]
DESIGNATED CONTRACTING STATES MENTIONED IN A PATENT
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19980506 EP/B1 [+]
PATENT SPECIFICATION

19980506 EP/REF-R [+]
IN AUSTRIA REGISTERED AS:
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19980610 EP/GBT [+]
GB: TRANSLATION OF EP PATENT FILED (GB SECTION 77(6)(A)/1977)
980519

19980610 EP/REF-P
CORRESPONDS TO:
(DE 59308494 19980610 [DE59308494])

19980616 EP/REG; ES/FG2A
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19980702 EP/ITF [+]
IT: TRANSLATION FOR A EP PATENT FILED
ING. C. GREGORJ S.P.A.

19981002 EP/ET [+]
FR: TRANSLATION FILED

19990428 EP/26N [+]
NO OPPOSITION FILED

20020101 EP/REG; GB/IF02 [+]
GB: EUROPEAN PATENT IN FORCE AS OF 2002-01-01
<GB>

UP - 2002-17

8 / 21 INPADOC - ©INPADOC

PN - EP 485821 B1 19960612 [EP-485821]
TI - METALLOCENES WITH 2-SUBSTITUTED INDENYL-DERIVATES AS LIGANDS,
PROCESS FOR THEIR PREPARATION AND THEIR USE AS CATALYSTS
LA - GER
IN - WINTER ANDREAS DR [DE]; ANTBERG MARTIN DR [DE]; SPALECK WALTER
DR [DE]; ROHRMANN JUERGEN DR [DE]; DOLLE VOLKER DR [DE]
PA - HOECHST AG [DE]
AP - EP 91118680/91-A 19911101 [1991EP-0118680]
PR - DE 4035884/90-A 19901112 [1990DE-4035884]
IC - C07F-017/00; C08F-004/602
DS - BE* DE* ES* FR* GB* IT* NL*

1 / 2 LEGALI - ©LEGSTAT

PN - DE 59107926 [DE59107926]
DT - DE-P
ACTE - 19960718 DE/REF-P
CORRESPONDS TO
(EP 485821 19960718 [EP-485821])

19970710 DE/8364 [+]
NO OPPOSITION DURING TERM OF OPPOSITION

UP - 1997-28

2 / 2 LEGALI - ©LEGSTAT

PN - EP 485821 [EP-485821]
AP - EP 91118680/91 19911101 [1991EP-0118680]
DT - EP-P
ACTE - 19911101 EP/AE-A
EP-APPLICATION
EP 91118680/91 19911101 [1991EP-0118680]

19920520 EP/AK-A1 [+]
DESIGNATED CONTRACTING STATES IN AN APPLICATION WITH SEARCH
REPORT:
BE DE ES FR GB IT NL

19920520 EP/A1 [+]
PUBLICATION OF APPLICATION WITH SEARCH REPORT

19920902 EP/17P [+]
REQUEST FOR EXAMINATION FILED
920701

19940727 EP/17Q [+]
FIRST EXAMINATION REPORT
940613

19960612 EP/AK-B1 [+]
DESIGNATED CONTRACTING STATES MENTIONED IN A PATENT
SPECIFICATION:
BE DE ES FR GB IT NL

19960612 EP/B1 [+]
PATENT SPECIFICATION

19960718 EP/REF-P
CORRESPONDS TO:
(DE 59107926 19960718 [DE59107926])

19960813 EP/ITF [+]
IT: TRANSLATION FOR A EP PATENT FILED
ING. C. GREGORJ S.P.A.

19960925 EP/GBT [+]
GB: TRANSLATION OF EP PATENT FILED (GB SECTION 77(6)(A)/1977)
960829

19960927 EP/ET [+]
FR: TRANSLATION FILED

19961016 EP/REG; ES/FG2A
ES: DEFINITIVE PROTECTION
2090209T3
<ES>

19961116 EP/REG; ES/FG2A
ES: DEFINITIVE PROTECTION
2090209T3
<ES>

19970604 EP/26N [+]
NO OPPOSITION FILED

20020101 EP/REG; GB/IF02 [+]
GB: EUROPEAN PATENT IN FORCE AS OF 2002-01-01
<GB>

UP - 2002-17

9 / 21 INPADOC - ©INPADOC

PN - EP 582194 B1 19980506 [EP-582194]
TI - PROCESS FOR THE PREPARATION OF POLYMERS USING METALLOCENES WITH SPECIFICALLY SUBSTITUTED INDENYL LIGANDS
LA - GER
IN - WINTER ANDREAS DR [DE]; KUEBER FRANK DR [DE]; SPALECK WALTER DR [DE]; RIEPL HERBERT [DE]; HERRMANN WOLFGANG ANTON PROF D [DE]; DOLLE VOLKER DR [DE]; ROHRMANN JUERGEN DR [DE]
PA - TARGOR GMBH [DE]
AP - EP 93112056/93-A 19930728 [1993EP-0112056]
PR - DE 4225649/92-A 19920803 [1992DE-4225649]
IC - C07F-017/00; C08F-010/00; C08F-004/642; C08F-004/76
DS - AT* BE* DE* ES* FR* GB* IT* NL* SE*

1 / 3 LEGALI - ©LEGSTAT

PN - DE 59308494 [DE59308494]
DT - DE-P
ACTE - 19980610 DE/REF-P
CORRESPONDS TO
(EP 582194 19980610 [EP-582194])

19990602 DE/8364 [+]
NO OPPOSITION DURING TERM OF OPPOSITION

20011018 DE/8327
CHANGE IN THE PERSON/NAME/ADDRESS OF THE PATENT OWNER
BASELL POLYPROPYLEN GMBH, 55116 MAINZ, DE
UP - 2001-42

2 / 3 LEGALI - ©LEGSTAT

PN - AT 165832 [ATE165832]
DT - AT-R
ACTE - 19980515 AT/REF-P
CORRESPONDS TO EP-PATENT
(EP 582194 19980506 [EP-582194])
UP - 1998-21

3 / 3 LEGALI - ©LEGSTAT

PN - EP 582194 [EP-582194]
AP - EP 93112056/93 19930728 [1993EP-0112056]
DT - EP-P
ACTE - 19930728 EP/AE-A
EP-APPLICATION

EP 93112056/93 19930728 [1993EP-0112056]

19940209 EP/AK-A1 [+]
DESIGNATED CONTRACTING STATES IN AN APPLICATION WITH SEARCH
REPORT:
AT BE CH DE ES FR GB IT LI LU NL SE

19940209 EP/A1 [+]
PUBLICATION OF APPLICATION WITH SEARCH REPORT

19940608 EP/17P [+]
REQUEST FOR EXAMINATION FILED
940414

19970108 EP/17Q [+]
FIRST EXAMINATION REPORT
961120

19971210 EP/RBV [+]
DESIGNATED CONTRACTING STATES (CORRECTION):
AT BE DE ES FR GB IT NL SE

19980304 EP/RAP1
APPLICANT REASSIGNMENT (CORRECTION)
TARGOR GMBH

19980506 EP/AK-B1 [+]
DESIGNATED CONTRACTING STATES MENTIONED IN A PATENT
SPECIFICATION:
AT BE DE ES FR GB IT NL SE

19980506 EP/B1 [+]
PATENT SPECIFICATION

19980506 EP/REF-R [+]
IN AUSTRIA REGISTERED AS:
(AT 165832 19980515 [ATE165832])

19980610 EP/GBT [+]
GB: TRANSLATION OF EP PATENT FILED (GB SECTION 77(6)(A)/1977)
980519

19980610 EP/REF-P
CORRESPONDS TO:
(DE 59308494 19980610 [DE59308494])

19980616 EP/REG; ES/FG2A
ES: DEFINITIVE PROTECTION
2114978T3
<ES>

19980702 EP/ITF [+]
IT: TRANSLATION FOR A EP PATENT FILED
ING. C. GREGORJ S.P.A.

19981002 EP/ET [+]
FR: TRANSLATION FILED

19990428 EP/26N [+]
NO OPPOSITION FILED

20020101 EP/REG; GB/IF02 [+]
GB: EUROPEAN PATENT IN FORCE AS OF 2002-01-01
<GB>

UP - 2002-17

10/21 INPADOC - ©INPADOC

PN - ES 2090209 T3 19961016 [ES2090209]
TI - METALOCENOS CON LIGANDOS BASADOS EN DERIVADOS DE INDENILO
SUSTITUIDOS EN POSICION 2, PROCEDIMIENTO PARA SU PREPARACION Y
SU EMPLEO COMO CATALIZADORES.
IN - WINTER ANDREAS DR [DE]; ANTBERG MARTIN DR [DE]; SPALECK WALTER
DR [DE]; ROHRMANN JURGEN DR [DE]; DOLLE VOLKER DR [DE]
PA - HOECHST AG
AP - ES 91118680/91-EP 19911101 [1991EP-0118680]
PR - DE 4035884/90-A 19901112 [1990DE-4035884]
IC - C07F-017/00; C08F-004/602

1/1 LEGALI - ©LEGSTAT

PN - ES 2090209 [ES2090209]
DT - ES-P
ACTE - 19961016 ES/FG2A
DEFINITIVE PROTECTION
485821
19961116 ES/FG2A
DEFINITIVE PROTECTION
485821
UP - 1996-49

11/21 INPADOC - ©INPADOC

PN - ES 2114978 T3 19980616 [ES2114978]
TI - PROCEDIMIENTO PARA LA OBTENCION DE UN POLIMERO DE OLEFINA
BAJO EMPLEO DE METALOCENOS CON LIGANDOS INDENILO DE
SUBSTITUCION ESPECIAL.
IN - WINTER ANDREAS DR [DE]; KUBER FRANK DR [DE]; SPALECK WALTER DR
[DE]; RIEPL HERBERT [DE]; HERRMANN WOLFGANG ANTON PROF D [DE];
DOLLE VOLKER DR [DE]
PA - TARGOR GMBH
AP - ES 93112056/93-EP 19930728 [1993EP-0112056]
PR - DE 4225649/92-A 19920803 [1992DE-4225649]
IC - C07F-017/00; C08F-010/00; C08F-004/642; C08F-004/76

1/1 LEGALI - ©LEGSTAT

PN - ES 2114978 [ES2114978]
DT - ES-P
ACTE - 19980616 ES/FG2A
DEFINITIVE PROTECTION
582194
UP - 1998-26

12/21 INPADOC - ©INPADOC

PN - JP 3268903 B2 20020325 [JP3268903]
AP - JP 192584/93-A 19930803 [1993JP-0192584]
PR - DE 4225649/92-A 19920803 [1992DE-4225649]
IC - C08F-010/00; C08F-004/642

13/21 INPADOC - ©INPADOC

PN - JP 3282839 B2 20020520 [JP3282839]
AP - JP 294690/91-A 19911111 [1991JP-0294690]
PR - DE 4035884/90-A 19901112 [1990DE-4035884]
IC - C07F-017/00; C07F-007/00; C08F-004/642; C08F-010/00

14/21 INPADOC - ©INPADOC

PN - JP 6157661 A2 19940607 [JP06157661]
TI - PRODUCTION OF OLEFIN POLYMER USING METALLOCENE CONTAINING
INDENYL LIGAND SUBSTITUTED SPECIFICALLY
IN - ANDOREASU BUINTAA; FURANKU KIYUUBAA; BUARUTAA
SHIYUPARETSUKU; HERUBERUTO RIIPURU; BUORUFUGANGU ANTON
HERUMAN; FUORUKAA DOORE; YURUGEN ROOAMAN
PA - HOECHST AG
AP - JP 192584/93-A 19930803 [1993JP-0192584]
PR - DE 4225649/92-A 19920803 [1992DE-4225649]
IC - C08F-010/00; C08F-004/642

15/21 INPADOC - ©INPADOC

PN - JP 6340684 A2 19941213 [JP06340684]
TI - METALLOCENE HAVING LIGAND OF 2-SUBSTITUTED INDENYL DERIVATIVE, ITS PRODUCTION AND METHOD OF USING IT
IN - ANDOREASU UNTAA; MARUTEIN ANTOBERUKU; UARUTAA SHIYUPARETSUKU; YURUGEN ROORUMAN; FUORUKERU DOORE
PA - HOECHST AG
AP - JP 294690/91-A 19911111 [1991JP-0294690]
PR - DE 4035884/90-A 19901112 [1990DE-4035884]
IC - C07F-017/00; C07F-007/00; C08F-004/642; C08F-010/00

16/21 INPADOC - ©INPADOC

PN - US 37208 E1 20010605 [US--37208]
TI - POLYOLEFINS PREPARED WITH METALLOCENE CATALYSTS HAVING 2-SUBSTITUTED INDENYL TYPE LIGANDS
IN - WINTER ANDREAS [DE]; ANTBERG MARTIN [DE]; SPALECK WALTER [DE]; ROHRMANN J UUML RGEN [DE]; DOLLE VOLKER [DE]
PA - TARGOR GMBH [US]
AP - US 324260/94-A 19941017 [1994US-0324260]
PR - US 324260/94-A 19941017 [1994US-0324260]
DE 4035884/90-A 19901112 [1990DE-4035884]
US 789361/91-A5 19911108 [1991US-0789361]
IC - C08F-110/00; C07F-007/28; C07F-009/00; C07F-011/00

17/21 INPADOC - ©INPADOC

PN - US 37573 E1 20020305 [US--37573]
TI - PROCESS FOR THE PREPARATION OF AN OLEFIN POLYMER USING METALLOCENES CONTAINING SPECIFICALLY SUBSTITUTED INDENYL LIGANDS
IN - WINTER ANDREAS [DE]; KUEBER FRANK [DE]; SPALECK WALTER [DE]; RIEPL HERBERT [DE]; HERRMANN WOLFGANG A [DE]; DOLLE VOLKER [DE]; ROHRMANN JUERGEN [DE]
PA - BASELL POLYOLEFIN GMBH [US]
AP - US 252719/99-A 19990219 [1999US-0252719]
PR - US 252719/99-A 19990219 [1999US-0252719]
DE 4035884/90-A 19901112 [1990DE-4035884]
DE 4225649/92-A 19920803 [1992DE-4225649]
US 101408/93-A5 19930803 [1993US-0101408]
US 789361/91-A2 19911108 [1991US-0789361]
IC - C07F-017/00; C07F-009/00; C07F-007/28; C07F-011/00

18/21 INPADOC - ©INPADOC

PN - US 5276208 A 19940104 [US5276208]
TI - METALLOCENES CONTAINING LIGANDS OF 2-SUBSTITUTED IDENYL
DERIVATIVES, PROCESS FOR THEIR PREPARATION, AND THEIR USE AS
CATALYSTS
IN - WINTER ANDREAS [DE]; ANTBERG MARTIN [DE]; SPALECK WALTER [DE];
ROHRMANN JUERGEN [DE]; DOLLE VOLKER [DE]
PA - HOECHST AG [DE]
AP - US 789361/91-A 19911108 [1991US-0789361]
PR - DE 4035884/90-A 19901112 [1990DE-4035884]
IC - C07F-007/28; C07F-009/00; C07F-011/00

1/1 LEGALI - ©LEGSTAT

PN - US 5276208 [US5276208]
AP - US 789361/91 19911108 [1991US-0789361]
DT - US-P
ACTE - 19911108 US/AE-A
APPLICATION DATA (PATENT)
US 789361/91 19911108 [1991US-0789361]

19911108 US/AS02
ASSIGNMENT OF ASSIGNOR'S INTEREST
HOECHST AKTIENGESSELLSCHAFT, A CORP. OF FED. REP. OF GERMANY
D-6230 FRANKFURT AM * WINTER, ANDREAS : 19911008; ANTBERG, MARTIN
: 19911008; SPALECK, WALTER : 19911008; ROHRMANN, JURGEN : 19911008;
DOLLE, : 19911008

19940104 US/A
PATENT

19980317 US/RF
REISSUE APPLICATION FILED
970717

19980407 US/RF
REISSUE APPLICATION FILED
970717
UP - 1999-11

19/21 INPADOC - ©INPADOC

PN - US 5455365 A 19951003 [US5455365]
TI - PROCESS FOR THE PREPARATION OF AN OLEFIN POLYMER USING
METALLOCENES CONTAINING SPECIFICALLY SUBSTITUTED INDENYL
LIGANDS
IN - WINTER ANDREAS [DE]; KUEBER FRANK [DE]; SPALECK WALTER [DE];
RIEPL HERBERT [DE]; HERRMANN WOLFGANG A [DE]; DOLLE VOLKER [DE];
ROHRMANN JUERGEN [DE]
PA - HOECHST AG [DE]
AP - US 101408/93-A 19930803 [1993US-0101408]
PR - DE 4225649/92-A 19920803 [1992DE-4225649]
IC - C07F-017/00; C07F-009/00; C07F-007/28; C07F-011/00

1/1 LEGALI - ©LEGSTAT

PN - US 5455365 [US5455365]
AP - US 101408/93 19930803 [1993US-0101408]
DT - US-P
ACTE - 19930803 US/AE-A
APPLICATION DATA (PATENT)
US 101408/93 19930803 [1993US-0101408]

19931206 US/AS02
ASSIGNMENT OF ASSIGNOR'S INTEREST
HOECHST AG ZENTRALE PATENTABTEILUNG GEBAUDE F 821 D-65926
FRANKFURT AM MAIN GERM * WINTER, ANDREAS : 19931112; KUBER,
FRANK : 19931112; SPALECK, WALTER : 19931112; RIEPL, HERBERT : 19931112;
HERRMANN, WO : 19931112;

19951003 US/A
PATENT

19970304 US/CC
CERTIFICATE OF CORRECTION

19990413 US/RF
REISSUE APPLICATION FILED
19990219
UP - 1999-17

20 / 21 INPADOC - ©INPADOC

PN - US 5869584 A 19990209 [US5869584]
TI - PROCESS FOR THE PREPARATION OF AN OLEFIN POLYMER USING
METALLOCENES CONTAINING SPECIFICALLY SUBSTITUTED INDENYL
LIGANDS
IN - WINTER ANDREAS [DE]; KUEBER FRANK [DE]; SPALECK WALTER [DE];
RIEPL HERBERT [DE]; HERRMANN WOLFGANG ANTON [DE]; DOLLE
VOLKER [DE]; ROHRMANN JUERGEN [DE]
PA - TARGOR GMBH [DE]
AP - US 458428/95-A 19950602 [1995US-0458428]
PR - US 458428/95-A 19950602 [1995US-0458428]
DE 4225649/92-A 19920803 [1992DE-4225649]
US 101408/93-A3 19930803 [1993US-0101408]
IC - C08F-004/602; C08F-010/00

1 / 1 LEGALI - ©LEGSTAT

PN - US 5869584 [US5869584]
AP - US 458428/95 19950602 [1995US-0458428]
DT - US-P
ACTE - 19950602 US/AE-A
APPLICATION DATA (PATENT)
US 458428/95 19950602 [1995US-0458428]

19990209 US/A
PATENT
UP - 1999-12

21 / 21 INPADOC - ©INPADOC

PN - ZA 9108927 A 19920729 [ZA9108927]
TI - METALLOCENES CONTAINING LIGANDS OF 2-SUBSTITUTED INDENYL
DERIVATIVES, PROCESS FOR THEIR PREPARATION, AND THEIR USE AS
CATALYSTS
IN - WINTER ANDREAS; ANDREAS WINTER; SPALECK WALTER; WALTER
SPALECK; DOLLE VOLKER; VOLKER DOLLE; ANTBERG MARTIN; MARTIN
ANTBERG; ROHRMANN JUERGEN; JUERGEN ROHRMANN
PA - HOECHST AG
AP - ZA 8927/91-A 19911111 [1991ZA-0008927]
PR - DE 4035884/90-A 19901112 [1990DE-4035884]
IC - C07F-000/00; C08F-000/00

PATNO IS 5276208

DATE: NOVEMBER 1, 2002
LIBRARY: PATENT
FILE: ALL

Your search request is:
PATNO IS 5276208

Number of PATENTS found with your search request through:
LEVEL 1... 1

Your search request has found 1 PATENT through Level 1.
To DISPLAY this PATENT press either the KWIC, FULL, CITE or SEGMENTS key.
To MODIFY your search request, press the M key (for MODIFY) and then the ENTER key.

For further explanation, press the H key (for HELP) and then the ENTER key.

LEVEL 1 - 1 PATENT

1.45276208, January 4, 1994 , Metallocenes containing ligands of 2-substituted
idenyl derivatives, process for their preparation, and their use as catalysts ,
Winter, Andreas, Glashutten, DEX; Anthberg, Martin, Hofheim am Taunus, DEX;
Spaleck, Walter, Liederbach, DEX; Rohrmann, Jurgen, Liederbach, DEX; Dolle,
Volker, Kelkheim, DEX, 07789361 (07), Hoechst Aktiengesellschaft, Frankfurt,
DEX

CORE TERMS: sub, sup, mmol, metallocene, mixture, compound, atom, formula,
stirred, polymerization ...

LEVEL 1 - 1 OF 1 PATENT

UNITED STATES PATENT AND TRADEMARK OFFICE GRANTED PATENT

5276208

January 4, 1994

Metallocenes containing ligands of 2-substituted indenyl derivatives, process for their preparation, and their use as catalysts

REISSUE: June 5, 2001 - This Patent was reissued on Jun. 5, 2001 as Reissue Patent Re 37,208. Reissue Application filed Jul. 17, 1997 (O.G. Apr. 7, 1998) Ex. Gp.: 1505; Re. S.N. 08/895,950 Reissue Application filed Jul. 17, 1997 (O.G. Mar. 17, 1998) Ex. Gp.: 1621; Re. S.N. 08/895, 909 April 7, 1998

APPL-NO: 07789361 (07)

FILED-DATE: November 8, 1991

GRANTED-DATE: January 4, 1994

CORE TERMS: sub, sup, mmol, metallocene, mixture, compound, atom, formula, stirred, polymerization ...

ENGLISH-ABST:

The novel metallocenes of the formula I [See chemical structure in original] in which, preferably, M.sup.1 is Zr or Hf, R.sup.1 and R.sup.2 are alkyl or halogen, R.sup.3 and R.sup.4 are hydrogen, R.sup.5 and R.sup.6 are alkyl or haloalkyl, -- (CR.sup.8 R.sup.9).sub.m -- R.sup.7 -- (CR.sup.8 R.sup.9).sub.n -- is a single- or multi-membered chain in which R.sup.7 may also be a (substituted) hetero atom, m+n is zero or 1, and R.sup.10 is hydrogen, form, together with aluminoxanes as cocatalysts, a very effective catalyst system for the preparation of polyolefins of high stereospecificity and high melting point.

5276208 OR 5,276,208

Your search request has found 1 CASE through Level 1.
To DISPLAY this CASE press either the KWIC, FULL, CITE or SEGMENTS key.
To MODIFY your search request, press the M key (for MODIFY) and then the ENTER key.

For further explanation, press the H key (for HELP) and then the ENTER key.

DATE: NOVEMBER 1, 2002

CLIENT:
LIBRARY: PATENT
FILE: CASES

YOUR SEARCH REQUEST IS:
5276208 OR 5,276,208

NUMBER OF CASES FOUND WITH YOUR REQUEST THROUGH:
LEVEL 1... 1

1ST CASE of Level 1 printed in FULL format.

ANDREAS WINTER, FRANK KUEBER, WALTER SPALECK, HERBERT RIEPL,
WOLFGANG A. HERRMANN, VOLKER DOLLE and JUERGEN ROHRMANN, Junior Party,
(Patent
5,455,365), v. TAKASHI FUJITA, TOSHIHIKO SUGANO and HIDESHI UCHINO,
Senior Party
(Application 08/678,686).
WALTER SPALECK, JUERGEN ROHRMANN and MARTIN ANTBERG, Junior Party,
(Patent
5,329,033), v. TAKASHI FUJITA, TOSHIHIKO SUGANO and HIDESHI UCHINO,
Senior Party
(Application 08/678,686).

Patent Interference No. 104,283

Patent Interference No. 104,284

Board of Patent Appeals and Interferences

1999 Pat. App. LEXIS 7; 53 U.S.P.Q.2D (BNA) 1234

November 16, 1999, Entered

CORE TERMS: metallocene, patent, reissue, catalyst, reply, designated,
corresponding, compound, invention, interference-in-fact, subject matter,
formula, ring, polymerization, substituent, methyl, aluminoxane, accorded,
olefin, preferably, examiner, correspond, hydrogen, species, alkyl, written
description, declaration, consisting, presume, patentable invention

[*1]

Before: STONER, n1 Chief Administrative Patent Judge, McKELVEY, Senior
Administrative Patent Judge, and SCHAFER, LEE n2 and TORCZON, Administrative
Patent Judges.

n1 Chief Judge Stoner joins in Parts I-A, III-A, III-B and IV of the opinion,
all of which are binding precedent of the Trial Section; Chief Judge Stoner
otherwise did not participate in deciding these interferences.

n2 Judge Lee joins in Parts I-A, III-A, III-B and IV of the opinion, all of
which are binding precedent of the Trial Section; Judge Lee otherwise did not
participate in deciding these interferences.

OPINIONBY: McKELVEY

OPINION:

Parts I-A, III-A, III-B and IV of this opinion are binding precedent of the
Trial Section.

MEMORANDUM IN SUPPORT OF FINAL JUDGMENTS

McKELVEY, Senior Administrative Patent Judge.

Interference 104,283 and Interference 104,284 are before a merits panel for entry of final decisions. Since the issues raised in both interferences are similar, the interferences are consolidated for oral argument and entry of final decisions.

Oral argument was held on 29 September 1999 before Judges McKelvey, Schafer and Torczon. Chief Judge Stoner and Judge Lee have participated in, and join, in Parts [*2] I-A, III-A, III-B and IV of this opinion.

Ashley I. Pezzner, Esq. (argued-in-part), and Thomas M. Meshbesh, Esq. (argued-in-part), appeared on behalf of Winter and Spaleck.

Charles L. Gholz, Esq., and Alton D. Rollins, Esq. (argued), appeared on behalf of Fujita.

Oral argument was transcribed by a court reporter. A copy of a transcript of oral argument has been made part of the record in each interference.

Findings of fact

The records in Interference 104,283 and Interference 104,284 support, by a preponderance of the evidence, the following findings, as well as those set out in the opinion portion of this memorandum.

Junior party--Interference 104,283

1. The junior party is Andreas Winter, Frank Kueber, Walter Spaleck, Herbert Riepl, Wolfgang A. Herrmann, Volker Dolle and Juergen Rohrmann (Winter). n3

n3 A list of abbreviations used in this opinion appears in an Appendix to the opinion. The first use of an abbreviation is in bold.

2. Winter is involved on the basis of its U.S. Patent 5,455,365, granted 3 October 1995, based on application 08/101,408, filed 3 August 1993.

3. The real party in interest is Targor GmbH (283 Paper 10).

Junior party--Interference [*3] 104,284

4. The junior party in Interference 104,284 is Walter Spaleck, Juergen Rohrmann and Martin Antberg (Spaleck).

5. Spaleck is involved in Interference 104,284 on the basis of its U.S. Patent 5,329,033, granted 12 July 1994, based on application 08/142,512, filed 25 October 1993.

6. For the purpose of priority with respect to Count 1 of Interference 104,284, Spaleck has been accorded the benefit of U.S. application 07/934,573,

filed 24 August 1994, now U.S. Patent 5,278,264, granted 11 January 1994.

7. The real party in interest is Targor GmbH (284 Paper 9).

Senior party--both interferences

8. The senior party in both interferences is Takashi Fujita, Toshihiko Sugano and Hideshi Uchino (Fujita).

9. Fujita is involved in both interferences on the basis of its application 08/678,686, filed 11 July 1996.

10. For the purpose of priority with respect to Count 1 of Interference 104,283 and Count 1 of Interference 104,284, Fujita has been accorded the benefit of:

- a. U.S. application 07/933,215, filed 20 August 1992, and
- b. Japanese patent application 208213/1991, filed 20 August 1991 (283 Paper 25, page 2; 284 Paper 23, page 2).

11. The real party in interest[*4] is Mitsubishi Chemical Corporation (283 Paper 6).

The count and claims of the parties corresponding to the count--Interference 104,283

12. The sole count in Interference 104,283 is Count 1, which reads (283 Paper 1, page 42):

The metallocene compound according [to] claim 1 of the Winter patent or the catalyst according to claim 8 of the Fujita application wherein the methyl or phenyl of the R<2> (which is selected from the group consisting of methyl-1, 3-butadienylene or phenyl-1, 3-butadienylene) is attached to the 5-position of any indene ring.

13. The claims of the parties are:

Winter	1-6
Fujita	8-19

14. The claims of the parties which correspond to Count 1 are:

Winter	1-6
Fujita	8-14 and 16

15. The claims of the parties which do not correspond to Count 1 are:

Winter	None
Fujita	15 and 17-19

The count and claims of the parties corresponding to the count of

Interference 104,284

16. The sole count in Interference 104,284 is Count 1, which reads (284 Paper 1, page 42):

The metallocene compound according [to] claim 1 of the Spaleck patent or the catalyst according to claim 8 of the Fujita application wherein the methyl or phenyl of the R<2> [*5] (which is selected from the group consisting of methyl-1, 3-butadienylene or phenyl-1, 3-butadienylene) is attached to the 4-position of any indene ring.

17. The claims of the parties are:

Spaleck	1-4
Fujita	8-19

18. The claims of the parties which correspond to Count 1 of Interference 104,284 are:

Spaleck	1-4
Fujita	8-13, 15 and 17-18

19. The claims of the parties which do not correspond to Count 1 of Interference 104,284 are:

Spaleck	None
Fujita	14, 16 and 19

Metallocenes

20. Metallocenes are compounds which can be used as a component of a catalyst in a process for polymerizing olefins.

21. An example of a metallocene is one having the following formula:

where M is a metal, such as zirconium (Zr). The R's can be various organic moieties, such as methyl () CH(3)).

[SEE ILLUSTRATION IN ORIGINAL]

22. The numbers in the formula identify the positions on the ring structures. The metallocene shown has an R[4] in both the 5 and 5' positions. As will become apparent, the position at which organic moieties are attached to the ring structure is not without significance.

Subject matter claimed by Winter in Interference 104,283

23. Winter claims[*6] metallocene compounds having the formula:

[SEE ILLUSTRATION IN ORIGINAL]

24. Important in Interference 104,283 is the position on the ring and definition of R<4> and R<5>, as well as R<3>.

25. According to Winter claim 1, the broadest Winter claim designated as corresponding to Count 1 of Interference 104,283, R<3>, R<4> and R<5> are defined as follows:

R<3>, R<4> and R<5> are identical or different and R<3> and R<4> and/or R<5> are other than hydrogen and are a C[1]-C[20]-alkyl group, a C[6]-C[20]-aryl group, a C[2]-C[10]-alkenyl group, a C[7]-C[40]-arylalkyl group, a C[7]-C[40]-alkylaryl group or a C[8]-C[40]-arylalkenyl group, these radicals optionally being halogenated, [and]

R<5> may alternatively be hydrogen.

26. In its Preliminary Motion 2, Winter states that (283 Paper 27, page 5):

Winter's claimed metallocenes are directed to a 2, 5-substituted indenyl ligand, n4 a 2, 6-substituted indenyl ligand n5 or a 2, 5, 6-substituted indenyl ligand n6 metallocene.

n4 When the R<5>s are hydrogen and the R<4>s are not hydrogen.

n5 When R<4>s are hydrogen and R<5>s are not hydrogen.

n6 When none of the R<4>s and R<5>s are hydrogen.

27. According to Winter, [*7] the metallocene and a cocatalyst together can be used as a catalyst to polymerize olefins (col. 1, lines 30-55).

28. The cocatalyst can be an aluminoxane (col. 5, lines 33-50).

29. According to Winter (col. 6, lines 34-50):

It is possible to preactivate the metallocene by means of an aluminoxane * *
* before use in the polymerization reaction.

* * * *

The preactivation of the transition-metal compound is carried out in solution.

* * * *

The concentration of the aluminoxane in the solution is in the region of about 1% by weight to the saturation limits, preferably from 5 to 30% by weight, in each case based on the total solution. The metallocene can be employed in the

same concentration, but is preferably employed in an amount of from 10^{-4} to 1 mol per mole of aluminoxane. The preactivation time is from 5 minutes to 60 hours, preferably from 5 to 60 minutes. The reaction temperature is from -78 [degrees] C. to 100 [degrees] C., preferably from 0 [degree] to 70 [degrees] C.

30. Further according to Winter (col. 7, lines 5-10):

When the above mentioned cocatalysts are used, the actual (active) polymerization catalyst comprises the product of the reaction of the metallocene and[*8] one of said compounds. This reaction product is therefore prepared first, preferably outside the polymerization reactor, in a separate step using a suitable solvent.

Subject matter claimed by Spaleck in Interference 104,284

31. Spaleck claims metallocene compounds having the formula:

[SEE ILLUSTRATION IN ORIGINAL]

32. Important in Interference 104,284 is the position on the ring and definition of $R_{<3>}$ and $R_{<4>}$. According to Spaleck claim 1, the broadest Spaleck claim designated as corresponding to Count 1 of Interference 104,284, $R_{<3>}$ and $R_{<4>}$ are defined as follows:

$R_{<3>}$ and $R_{<4>}$ are identical or different and are a halogen atom, a $C[1]-C[10]$ -alkyl group, which can be halogenated, a $C[6]-C[10]$ -aryl group or an $]NR[2]<10>$, $]SR<10>$, $]OSiR[3]<10>$, $]SiR[3]<10>$ or $]PR[2]<10>$ radical, in which $R_{<10>}$ is a halogen atom, a $C[1]-C[10]$ -alkyl group or a $C[6]-C[10]$ -aryl group.

33. Further, according to Spaleck, the metallocene and a cocatalyst can be used to polymerize olefins (col. 2, lines 23-50).

34. The cocatalyst can be an aluminoxane (col. 8, lines 22-41).

35. Spaleck says (col. 8, line 67 through col. 9, line 50):

It is possible for the metallocene to be preactivated[*9] with an aluminoxane * * * before use in the polymerization reaction.

* * * *

The preactivation of the transition metal compound is carried out in solution.

* * * *

The concentration of the aluminoxane in the solution is in the range from about 1% by weight to the saturation limit, preferably from 5 to 30% by weight, in each case based on the total solution. The metallocene can be employed in the same concentration, but it is preferably employed in an amount of 10^{-4} -1 mol per mole of aluminoxane. The preactivation time is 5 minutes to 60 hours, preferably 5 to 60 minutes.

* * * *

If the above mentioned cocatalysts are used, the actual (active) polymerization catalyst comprises the reaction product of the metallocene and one of the compounds mentioned. This reaction product is therefore preferably prepared first outside the polymerization reactor in a separate step using a suitable solvent * * *.

Difference between the Winter and Spaleck metallocenes

36. A significant difference between the metallocenes claimed by Winter and those claimed by Spaleck is the position of moieties on the ring structure. In the case of Winter, R<4> is located at the 5- and 5'-positions. Spaleck, [*10] on the other hand, requires that R<3> and R<4> be at the 4- and 4'-positions.

37. The Winter activated metallocenes are said to produce polyolefins which "preferably have a molecular weight $M_w > 80,000$, in particular $> 100,000$ g/mol, a melting point of < 145 [degrees] C. and a molecular weight dispersity $M[w]/M[n]$ [ILLEGIBLE WORD] 3.5, in particular [ILLEGIBLE WORD] 2.8" (col. 8, lines 10-12).

38. The Spaleck patent states (col. 10, lines 41-51):

The process according to the invention is distinguished by the fact that the metallocene catalyst systems described produce polymers having a narrow molecular weight distribution and coarse particle morphology as well as variable molecular weight and stereotacticity in the temperature range between 30 [degrees] and 80 [degrees] C., which is of industrial interest, but in particular in the range between 60 [degrees] and 80 [degrees] C. The particular polymer molecular weight and stereotacticity desired is established by choosing suitable substituents in the 2- and 4-positions of the ligand system of the metallocene [i.e., the ring portion of the metallocene].

Subject matter claimed by Fujita in both interferences

39. The Fujita application[*11] involved in both interferences contains claims 8-19. Claim 8 is the sole independent claim and reads as follows:

A catalyst useful for the polymerization of olefins, which catalyst comprises a transition metal compound having formula (I)

[SEE ILLUSTRATION IN ORIGINAL]

wherein:

M represents a transition metal selected from the group consisting of titanium, zirconium and hafnium;

two R<1>s may be the same or different, and each represents a monovalent hydrocarbyl group having 1 to 4 carbon atoms, or a monovalent hydrocarbyl group having 1 to 4 carbon atoms and containing silicon;

R<2> is selected from the group consisting of methyl-1,3-butadienylene and phenyl-1,3-butadienylene;

R<3> is selected from the group consisting of a methylene group, an ethylene group and a silylene group which may or may not have a substituent of a lower alkyl group; and

X and Y independently represent a member selected from the group consisting of chlorine, lower alkyl and a lower alkyl substituted silyl group, provided that the two five-membered cyclic ligands each have the substituents R<1> and R<2> are asymmetric about a plane containing M when viewed from their relative position in terms of the group[*12] R[3]. n7

[EDITOR'S NOTE: TEXT WITHIN THESE SYMBOLS [O> <O] IS OVERSTRUCK IN THE SOURCE.]

n7 Perhaps the "provided" paragraph should read: "provided that the two five-membered cyclic ligands each have the substituents R<1> and R<2> [O> are <O] asymmetric about a plane containing M when viewed from their relative position in terms of the group R[3].

40. Fujita claims 14-19 call for specific metallocenes.

41. Fujita claims 14 and 16 call for a methyl group at the 5- and 5'-positions. Accordingly, these claims were designated to correspond to the count in Interference 104,283, but not to the count in Interference 104,284.

42. Fujita claims 15, 17 and 18 call for a methyl or phenyl group in the 4- and 4'-positions. Accordingly, these claims were designated to correspond to the count in Interference 104,284, but not the count in Interference 104,283.

43. Fujita claim 19 calls for a methyl group in both the 4-, 4'-, 7- and 7'-positions. The examiner determined that Fujita claim 19 should be designated as not corresponding to the count in either interference. The examiner's determination is not contested by Winter, Spaleck or Fujita.

44. Fujita claims 8-13 mention a metallocene [*13] which is "generic" in the sense that a substituent may appear in either the 4- and 4'- or 5- and 5'-positions. Accordingly, these claims were designated as corresponding to the count in both interferences.

45. According to the specification of the involved Fujita application, the invention "comprises the following component (A) and component (B)" (page 2, lines 22-23).

46. Component (A) is a metallocene (page 2, line 24 et seq.).

47. Component (B) is an aluminoxane (page 3, line 25 et seq.).

48. According to Fujita (page 13, lines 5-9):

The catalyst according to the present invention can be prepared by bringing

the above-described component (A) and component (B) into contact with each other in the presence or absence of monomers to be polymerized, inside or outside an autoclave.

49. Further according to Fujita (page 13, lines 29-33):

When the above catalyst system is used for the polymerization of an olefin, the components (A) and (B) may be introduced into a reaction vessel either separately or after being brought into contact with each other.

50. Fujita, acting as its own lexicographer, states in its specification (page 4, lines 16-20):

The expression "comprising[*14] component (A) and component (B)" herein means that it is possible to use a third component other than components (A) and (B) as long as it does not impair the effects of the present invention. n8

n8 It would appear that Fujita could have used the language "consisting essentially" in place of defining "comprising" in a manner contrary to its normal meaning. Compare *In re Janakirama-Rao*, 317 F.2d 951, 954, 137 USPQ 893, 896 (CCPA 1963) (the presence of "consisting essentially of" in a composition claim leaves the scope of the claim open only to the inclusion of unspecified ingredients which do not materially affect the basic and novel characteristics of the composition); *Ex parte Davis*, 80 USPQ 448, 450 (Bd. App. 1948) (definition of comprising, consisting and consisting essentially). See also *PPG Industries, Inc. v. Guardian Industries Corp.*, 156 F.3d 1351, 1354, 48 USPQ2d 1351, 1353-1354 (Fed. Cir. 1998).

Preliminary and other motions before the merits panel

51. In their respective preliminary statements, the parties do not allege a conception or actual[*15] reduction to practice prior to their filing dates.

52. Winter and Spaleck have filed several preliminary motions.

53. Fujita did not file any preliminary motion.

54. Accordingly, each party is restricted to its filing date subject to an effort by Winter (Preliminary Motion 2) and Spaleck (Preliminary Motion 2) to be accorded the benefit of the filing date of earlier U.S. and German patent application.

55. Hence, a decision on preliminary motions resolves the interferences (283 Paper 25, page 3; 284 Paper 23, page 3; Tr 7:1-13).

56. The following preliminary motions and other motions are before the merits panel:

(1) Winter Preliminary Motion 1 for judgment based on no interference-in-fact between Winter and Fujita (283 Paper 26). 37 CFR § 1.633(b).

(2) Spaleck Preliminary Motion 1 for judgment based on no interference-in-fact between Spaleck and Fujita (284 Paper 25). 37 CFR § 1.633(b).

(3) Winter Preliminary Motion 2 to be accorded benefit of two prior U.S. patent applications and a German patent application filed 12 November 1990 (283 Paper 27). 37 CFR § 1.633(f).

(4) Spaleck Preliminary Motion 2 to be accorded benefit of two prior U.S. patent applications and a German patent[*16] application filed 12 November 1990 (284 Paper 26). 37 CFR § 1.633(f).

(5) Winter Preliminary Motion 3 (283 Paper 28) to add to Interference 104,283, application 09/252,719, filed 19 February 1999 (Winter 719) (WEx 1001), n9 to reissue involved Winter U.S. Patent 5,455,365. 37 CFR § 1.633(h).

n9 The serial number (08/101,408) and filing date (August 3, 1993) mentioned on the first page of WEx 1001 are those for the application which matured into the patent sought to be reissued and not the reissue application.

(6) Spaleck Preliminary Motion 3 (284 Paper 27) to add to Interference 104,284, application 09/253,832, filed 19 February 1999 (Spaleck 832) (SEx 1001), n10 to reissue involved Spaleck U.S. Patent 5,329,033. 37 CFR § 1.633(h).

n10 The serial number (08/142,512) and filing date (October 25, 1993) mentioned on the first page of SEx 1001 are those for the application which matured into the patent sought to be reissued and not the reissue application.

(7) Winter Rule 635 motion (283 Paper 56) for leave to file a belated Winter Preliminary Motion 4 to question the enablement of the Fujita application.

(8) Spaleck Rule 635 motion (284 Paper 57) for leave to [*17] file a belated preliminary motion to question the enablement of the Fujita application.

(9) Fujita has filed a Rule 635 motion (283 Paper 50) to strike Winter Reply 1 (283 Paper 44). Winter Reply 1 was filed in response to Fujita's opposition to Winter Preliminary Motion 1.

(10) Fujita has filed a Rule 635 motion (284 Paper 51) to strike a Spaleck Reply 1 (284 Paper 44). Spaleck Reply 1 was filed in response to Fujita's opposition to Spaleck Preliminary Motion 1.

(11) Fujita has filed FUJITA MOTION 2, a Rule 635 motion (283 Paper 71; 284 Paper 72) seeking leave to file a declaration of Dr. Tobin Marks (FEx 2010).

Interference-in-fact

57. There is no claim in the involved Winter patent which is identical to a

claim in the involved Fujita application.

58. There is no claim in the involved Spaleck patent which is identical to a claim in the involved Fujita application.

59. The parties agree that Winter claim 1 is directed to compounds (283 Paper 26, page 3; 283 Paper 32, page 2).

60. The parties agree that Spaleck claim 1 is directed to compounds (284 Paper 25, page 3; 284 Paper 2).

61. The parties do not agree that Fujita claim 8--the sole independent Fujita claim--is directed to[*18] a compound.

62. In fact, Winter and Spaleck disagree with Fujita as to the scope and meaning of Fujita claim 8.

63. The parties agree that metallocene compounds have uses other than polymerization catalysts (283 Paper 26, page 3; 283 Paper 32, page 2; 284 Paper 25, page 3; 284 Paper 31, page 2).

64. Winter and Spaleck maintain that examiners have made requirements for restriction (35 U.S.C. § 121) between what they call "polymerization catalyst claims" and "metallocene claims" (283 Paper 26, page 3; 284 Paper 25, page 3).

Winter and Spaleck preliminary motions for benefit of earlier U.S. and German applications

65. Winter and Spaleck have filed preliminary motions to be accorded the benefit for the purpose of priority (37 CFR § 1.633(f)) of:

- a. U.S. application 08/101,408, filed 3 August 1993.
- b. U.S. application 07/789,361, filed 8 November 1991, now U.S. Patent 5,276,208, granted 4 January 1994.
- c. German patent application P 4 035 884.4, filed 12 November 1990.

66. Fujita does not oppose benefit with respect to application 08/101,408 (283 Paper 34, page 1; 284 Paper 33, page 1).

67. At oral argument, counsel for Fujita agreed that if[*19] Winter or Spaleck are entitled to benefit of application 07/789,361, they would also be entitled to benefit of the German patent application (283 Paper 61, page 3; 284 Paper 62, page 3; Tr 50:20 to 51:9).

68. Accordingly, the Winter and Spaleck preliminary motions for benefit will be resolved on the basis of whether Winter and Spaleck respectively are entitled to benefit for the purpose of priority of application 07/789,361, which is now U.S. Patent 5,276,208 (Patent 208) (WEx 1002; SEx 1002).

69. Patent 208 describes metallocenes (col. 1, lines 7 and 35-50).

70. Patent 208 states (col. 1, lines 7-11):

The present invention relates to novel metallocenes which contain ligands

[i.e., the ring structures] of 2-substituted indenyl derivatives and can very advantageously be used as catalysts in the preparation of polyolefins of high melting point (high isotacticity).

71. Patent 208 describes metallocenes having Formula I (col. 1, lines 40-55).

72. According to Patent 208, the metallocenes of Formula I can be made from compounds having Formula II (col. 4, lines 37-55):

[SEE ILLUSTRATION IN ORIGINAL]

wherein:

R<10> is identified as being identical or different and is as defined [*20] for R<11>, R<12> and R<13> (col. 3, lines 63-64).

73. R<11>, R<12> and R<13> can be a wide variety of moieties (col. 2, lines 25-33).

74. The metallocenes of Formula I do not fall within the scope of the count of Interference 104,283 or Interference 104,284; the 6-member rings of the metallocenes of Formula I are not aromatic.

75. On the other hand, the 6-member rings of the compound of Formula II are aromatic as is apparent from the circle inside the ring.

76. According to Patent 208 (col. 3, line 64 through col. 4, line 13):

The radicals R<10> are preferably hydrogen atoms or C[1]) C[10]), preferably C[1]) C[4]), alkyl groups.

The particularly preferred metallocenes are thus those in which * * * R<10> is hydrogen; in particular the compounds I listed in the working examples.

77. There is no description in Patent 208 of a metallocene having a non-hydrogen moiety R<10> group specifically in the 4-, 4'-, 5- or 5'-positions.

78. Rather, according to Patent 208, the compounds of Formula (II) have four R<10> groups some of which may be alkyl groups (e.g., methyl groups).

79. Patent 208 does not emphasize or describe any advantage of having an alkyl group in the 4-, 4'-, 5- or 5'-positions. [*21]

80. Rather, Patent 208 emphasizes a requirement that the R<5> and R<6> moieties in 2- and 2'-positions be something other than hydrogen (col. 2, lines 5-7; see also col. 1, line 67 et seq.), such as alkyl, particularly methyl (col. 3, lines 3-6).

81. At oral argument, Mr. Meshbesh, counsel for Winter and Spaleck, emphasized the importance of a moiety position on a metallocene ring as follows (Tr 34:9-12 and 39:13-21):

Well, each metallocene almost has to be considered on its merits because the positioning of groups of the 6-member ring of the metallocene affects its performance.

and

There is a difference in behavior -- well, they all have in common a substituent in the 2 position of the indenyl, but there's another 6-member ring and there it matters where -- let's say your substituent is a methyl group, it matters whether you put the methyl group at the 4, 5, 6 or 7 position, and it matters whether there are two methyl groups and where they happen to be located.

82. Mr. Meshbeshier's observations are factually correct and are supported by the record.

83. Patent 208 does not contain a written description of the subject matter claimed in the involved Winter patent. [*22]

84. Patent 208 does not contain a written description of the subject matter of Count 1 of Interference 104,283.

85. Patent 208 does not contain a written description of a species within the scope of the claims of the involved Winter patent.

86. Patent 208 does not contain a written description of a species within the scope of the count of Interference 104,283.

87. Patent 208 does not contain a written description of the subject matter claimed in the involved Spaleck patent.

88. Patent 208 does not contain a written description of the subject matter of Count 1 of Interference 104,284.

89. Patent 208 does not contain a written description of a species within the scope of the claims of the involved Spaleck patent.

90. Patent 208 does not contain a written description of a species within the scope of the count of Interference 104,284.

Addition of Winter 719 reissue application

91. Winter 719 reissue application contains claims 1-12.

92. Winters seeks to have claims 1-6 designated as corresponding to the count of Interference 104,283.

93. Claims 1-6 are identical to claims 1-6 of Winter's involved patent.

94. Fujita opposes Winter Preliminary Motion 3 on the ground that (283 Paper [*23] 36, page 3):

Winter seeks to amend the interference by adding to its reissue application claims to be designated as not corresponding to the count.

95. Accordingly, Fujita maintains that the "motion should be dismissed" (id.).

96. Alternatively, Fujita maintains that Winter 719 claims 7-12 should be designated as corresponding to Count 1 of Interference 104,283.

Addition of Spaleck 832 reissue application

97. Spaleck 832 reissue application contains claims 1-10.

98. Spaleck seeks to have claims 1-4 designated as corresponding to the count of Interference 104,284.

99. Claims 1-4 are identical to claims 1-4 of Spaleck's involved patent.

100. Fujita opposes Spaleck Preliminary Motion 3 on the ground that (284 Paper 35, page 3):

Spaleck seeks to amend the interference by adding to its reissue application claims to be designated as not corresponding to the count.

101. Accordingly, Fujita maintains that the "motion should be dismissed" (id.).

102. Alternatively, Fujita maintains that Spaleck 832 claims 5-10 should be designated as corresponding to Count 1 of Interference 104,284.

Background as to how issue of designation of new Winter and Spaleck reissue claims [*24] arose

103. Consistent with the practice of the Trial Section, prior to setting the times for taking action during the preliminary motion phase of the interference, a conference call took place with counsel (see, e.g., 283 Paper 25, pages 1-2).

104. During the conference call, Winter and Spaleck indicated that they would file a reissue application and would move to add their respective reissue applications to the respective interferences.

105. As a result of the conference call, the following observation was made by the administrative patent judge designated to handle the interferences (283 Paper 25, page 2):

With respect to the preliminary motion to add a reissue application, it was indicated by Winter that it would be Winter's position that not all claims in the reissue application would be designated as corresponding to the count. In the event the preliminary motion is filed and Fujita believes that claims in the reissue application should be designated as corresponding to the count, Fujita should oppose the preliminary motion and request that additional reissue application claims be designated as corresponding to the count.

106. In due course, Winter filed Winter Preliminary[*25] Motion 3 and Spaleck filed Spaleck Preliminary Motion 3 to add their respective reissue applications.

107. As indicated earlier, Fujita responded by arguing that the preliminary motions should be dismissed.

108. Alternatively, Fujita argued that the preliminary motions should be granted only if all new claims in both reissue applications are designated as corresponding to a count.

109. Winter and Spaleck replied.

110. During the preliminary motion phase of the interference, Winter and Spaleck made an assumption that Fujita had the burden of proof to the extent Fujita sought to have new claims in the reissue applications designated as corresponding to the count. Given the state of the record, the assumption was not unreasonable.

111. Fujita made an assumption, and maintains to this day, that Winter and Spaleck had the burden of proof. Given the state of the record, Fujita's assumption is likewise not unreasonable.

112. Following oral argument on preliminary motions, Fujita was given an opportunity to respond to the Winter and Spaleck replies, principally in case it turned out that Fujita had the burden of proof.

113. The Fujita response was accompanied by FUJITA MOTION 2, a Rule 635 [*26]motion for leave to file a declaration of Dr. Tobin Marks (283 Paper 71; 284 Paper 72).

114. The declaration is said to be necessary to establish that the non-original patent claims in the Winter and Spaleck reissue applications are directed to the same invention as the count of the interference into which the reissue is sought to be added.

Opinion

Part I.

Interference-in-fact

A.

Winter maintains that there is no interference-in-fact between Winter and Fujita.

Spaleck maintains that there is no interference-in-fact between Spaleck and Fujita.

An "interference-in-fact" is a term of art in interference practice. The rules define an "interference-in-fact" as follows (37 CFR § 1.601(j)):

An interference-in-fact exists when at least one claim of a party that is designated to correspond to a count and at least one claim of an opponent that is designated to correspond to the count define the same patentable invention.

The rules define "same patentable invention" as follows (37 CFR § 1.601(n)):

Invention "A" is the same patentable invention as an invention "B" when invention "A" is the same as (35 U.S.C. 102) or is obvious (35 U.S.C. 103) [*27] in view of invention "B" assuming invention "B" is prior art with respect to invention "A". Invention "A" is a separate patentable invention with respect to invention "B" when invention "A" is new (35 U.S.C. 102) and non-obvious (35 U.S.C. 103) in view of invention "B" assuming invention "B" is prior art with respect to invention "A".

Subparts (j) and (n) of Rule 601 implement holdings of the former Court of Customs and Patent Appeals. See, e.g., *Aelony v. Arni*, 547 F.2d 566, 192 USPQ 486 (CCPA 1977) (an interference-in-fact held to exist between a claim to a method of using cyclopentadiene and a claim to a method using butadiene, isoprene, dimethylbutadiene, piperylene, anthracene, perylene, furan or sorbic acid; the claims were held to be directed to the same patentable invention even though they did not overlap in scope). See also Notice of Final Rule, Patent Interference Cases, 49 Fed. Reg. 48416 (Dec. 12, 1984) (see Examples 16 at 48421 and Example 20 at 48424).

An issue of whether an interference-in-fact exists[*28] is placed before the board by the filing of a preliminary motion under 37 CFR § 1.633(b). If the preliminary motion is granted, both parties would be entitled to a patent containing their respective claims initially designated as corresponding to the count because those claims would be determined to be directed to separate patentable inventions. n11

n11 See Notice of Final Rule, supra at 48440 ("Two comments questioned the nature of the judgment when a motion under § 1.633(b) is granted. Section 1.633(b) authorizes the filing of a [preliminary] motion for judgment on the ground that there is no interference-in-fact. If a [preliminary] motion under § 1.633(b) is granted, the judgment would provide that each party is entitled to a patent containing that party's claims corresponding to the count.").

Resolution of an interference-in-fact issue involves a two-way patentability analysis. The claimed invention of Party A is presumed to be prior art vis-a-vis Party B and vice versa. The claimed invention of Party A must anticipate or render obvious the claimed invention of Party B and the claimed invention of Party B must anticipate or render obvious the claimed invention [*29] of Party A. When the two-way analysis is applied, then regardless of who ultimately prevails on the issue of priority, the Patent and Trademark Office (PTO) assures itself that it will not issue two patents to the same patentable invention.

B.

Winter and Spaleck maintain that their respective patent claims and the claims of Fujita are directed to "separate patentable inventions" within the meaning of 37 CFR § 1.601(n). We understand the argument to be the following:

1. Winter and Spaleck claim metallocene compounds.
2. Metallocene compounds have utility other than as a catalyst for making polyolefins.

3. Fujita claim 8--the only independent Fujita claim--is directed to a catalyst system in which a metallocene is used as an ingredient for making an activated "catalyst system."

4. According to Winter and Spaleck a "catalyst system" involves a reaction product of the metallocene and an activator, alternatively, the metallocene and activator are somehow bound one with the other in some chemical fashion.

5. Examiners in the Patent and Trademark Office routinely have required restriction (35 U.S.C. § 121) between metallocenes per se[*30] and catalyst systems made from metallocenes.

6. A metallocene and a "catalyst system" made from a metallocene are separate patentable inventions and therefore there is no interference-in-fact between Winter/Spaleck and Fujita.

The party filing a preliminary motion for judgment alleging no interference-in-fact has a burden of proving its case by a preponderance of the evidence. See 37 CFR § 1.637(a), first sentence, and compare *Bruning v. Hirose*, 161 F.3d 681, 684, 48 USPQ2d 1934, 1937 (Fed. Cir. 1998) (burden of proof on the issue of patentability of the claims of a patent in an interference where applications are copending is by a preponderance of the evidence).

C.

At oral argument, it became apparent that the parties do not agree on the scope of, or the meaning of terms in, Fujita claim 8. The language of Fujita claim 8 which appears to create the disagreement is that which reads "A catalyst useful for the polymerization of olefins which catalyst comprises * * *." Fujita maintains that Fujita claim 8 covers a metallocene per se. Winter and Spaleck maintain that (1) Fujita claim 8 is limited to a "catalyst system," (2) does [*31]not cover a metallocene per se and (3) accordingly, there is no interference-in-fact.

Construction of the meaning of words in a patent claim is an issue of law to be resolved based on the facts of each case. *Markman v. Westview Instruments, Inc.*, 517 U.S. 370, 391, 116 S.Ct. 1384, 1396 (1996) (interpretation of the word "inventory" [in a patent claim] in this case is an issue for the judge, not the jury * * *.); *Ethicon Endo-Surgery, Inc. v. U.S. Surgical Corp.*, 93 F.3d 1572, 1577, 40 USPQ2d 1019, 1022 (Fed. Cir. 1996) (significance to be given a limitation in a patent claim is a question of law which is resolved based on particular facts).

D.

Fujita claim 8 could have been presented simply as "A transition metal compound having formula (I):" followed by Formula (I). It was not. Rather, it contains additional language which reads "A catalyst useful for the polymerization of olefins which catalyst comprises * * *." What is the significance, if any, of the additional language?

As a general proposition, we believe that it is appropriate, where possible, to assign some meaning to each word[*32] of a claim. Thus, like the words of

a statute, each word in a claim should be given meaning if possible.

The record reveals that Winter, Spaleck and Fujita describe metallocene compounds which when activated (generally with an aluminoxane) can be used to polymerize olefins. While it may be a matter of debate as to whether the Winter, Spaleck and/or Fujita metallocenes will function as a catalyst per se (see, e.g., Tr 13:18-22), there is little doubt that the metallocenes are, at least preferably, activated with a cocatalyst. Catalysis is not a precise science as evidenced by the different results which the Winter and Spaleck patents say are obtained depending on where substituents are placed on the ring structure. n12 It is possible that within the scope of the metallocenes of Formula (I) of Fujita claim 8, there may be some metallocene species, even when activated, which will not function for the utility described by Fujita. Fujita avoids any side-show issue of whether its enabling disclosure is commensurate in scope n13 with the breadth of Fujita claim 8 by limiting the metallocenes of Formula (I) to those which, when used in the manner described in the Fujita specification, [*33]will be "useful for the polymerization of olefins * * *."

n12 We wish to emphasize that the Winter and Spaleck patents are not admissible in evidence to prove the truth of statements made therein. See NOTICE DECLARING INTERFERENCE, P41. Each patent is admissible, however, to prove what is described therein and perhaps may be used as an admission by a party opponent. Each patent describes results which are said to be obtained when the metallocenes described therein are used to polymerize olefins.

n13 See, e.g., *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991) (given relative incomplete understanding in biotechnological field involved and the lack of a reasonable correlation between the narrow disclosure in Vaeck's specification and the broad scope of protection sought in the claims, PTO did not err in entering rejection based on 35 U.S.C. § 112, first paragraph, for lack of enablement); *In re Fisher*, 427 F.2d 833, 839, 166 USPQ 18, 24 (CCPA 1970) (the scope of enablement obviously varies inversely with the degree of unpredictability of the factors involved).
[*34]

In the context of the Fujita specification, the activated catalyst used to make polyolefins is some combination of a metallocene and an activator. Hence, Fujita's use of "which catalyst comprises" means that the catalyst must be a metallocene within the scope of Formula (I). In the final analysis, we agree with the following statement made at oral argument by Mr. Rollins, counsel for Fujita (Tr 59:5-14):

The Fujita claim has at most three limitations. One limitation is on the structure of the metallocene compound, and I think that's quite straightforward. Another limitation or both of the other limitations appear in the preamble. One limitation is that nothing is within the scope of the claim unless it's a catalyst, and whether you consider a part of the same limitation as the catalyst or a different limitation, it has to be a catalyst useful for the polymerization of olefins. n14

n14 See also Tr 66:6-16: "MR. ROLLINS: So if you have a compound which is a metallocene within the scope of the claim and it is capable of acting together with an activator or without an activator, either, to polymerize olefins, it's within the scope of the claim. It's rather that simple. JUDGE McKELVEY: Actually you meant to say if you have a metallocene within the scope of the formula --. MR. ROLLINS: Of the formula, that's correct."
[*35]

Based on our construction of Fujita claim 8, as outlined above, we hold, as a matter of law, that Fujita claim 8 covers a metallocene having Formula (I), but only those metallocenes within the scope of Formula (I) which can be used along with an activator to polymerize olefins. It further follows that Fujita dependent claims 14 and 16 cover specific metallocenes which fall within the scope of Winter claim 1. It still further follows that Fujita dependent claims 15, 17 and 18 cover specific metallocenes which fall within the scope of Spaleck claim 1.

E.

The subject matter of Fujita claims 14 and 16 anticipates (35 U.S.C. § 102) the subject matter of Winter claim 1, if one presumes--as we must in an interference-in-fact analysis--that the subject of Fujita claims 14 and 16 is prior art vis-a-vis Winter. Likewise, the subject matter of Winter claim 6 anticipates (35 U.S.C. § 102) the subject matter of Fujita claim 8 if one presumes that the subject matter of Winter claim 6 is prior art vis-a-vis Fujita. Hence, there is an interference-in-fact between the Winter claims and the Fujita claims designated as corresponding[*36] to the count of Interference 104,283. n15

n15 Winter has not moved to have any of its claims 1-6 designated as not corresponding to the count of Interference 104,283; hence, all Winter claims stand or fall together with respect to the interference-in-fact issue.

F.

The subject matter of Fujita claims 15, 17 and 18 anticipates (35 U.S.C. § 102) the subject matter of Spaleck claim 1, if one presumes that the subject of Fujita claims 15, 17 and 18 is prior art vis-a-vis Spaleck. Likewise, the subject matter of Spaleck claim 4 anticipates (35 U.S.C. § 102) the subject matter of Fujita claim 8 if one presumes that the subject matter of Spaleck claim 4 is prior art vis-a-vis Fujita. For example, the compound "rac-dimethylsilylbis(1-(2-methyl-4-ethyl-indenyl) zirconium dichloride" reads on Fujita claim 8 when:

- (1) M is zirconium;
- (2) R<2> is methyl-1,3-butadienylene (where the methyl is substituted at the 5- and 5'-positions)
- (3) R<3> is a silylene group substituted with two methyl groups (i.e., lower alkyl groups);

(4) X and Y are chloro groups.

Hence, there is an interference-in-fact between the Spaleck[*37] claims and the Fujita claims designated as corresponding to the count of Interference 104,284. n16

n16 Spaleck has not moved to have any of its claims 1-4 designated as not corresponding to the count of Interference 104,284; hence, all Spaleck claims stand or fall together with respect to the interference-in-fact issue. In particular, we note that with respect to the no interference-in-fact issue, Spaleck does not maintain that Spaleck claim 4 is entitled to any separate consideration, although later with respect to Preliminary Motion 3, Spaleck maintains that certain of (but not all) of the racemic metallocenes within the scope of Spaleck claim 4 are separately patentable from the count of Interference 104,284.

G.

Notwithstanding our construction of the scope of Fujita claim 8, we believe that Winter and Spaleck have failed to sustain their burden of establishing no interference-in-fact even if Fujita claim 8 is construed to be limited to a metallocene "catalyst system" activated with an aluminoxane.

Winter, Spaleck and Fujita ultimately use their respective metallocenes in the same manner. The metallocene and an activator, e.g., an aluminoxane, are mixed and then placed in a[*38] polymerization reactor or are mixed in the polymerization reactor along with the olefin monomer to be polymerized.

Given the similar manner in which all say their metallocenes are used, if one presumes that the Winter metallocene is prior art vis-a-vis Fujita, then it manifestly would have been obvious (35 U.S.C. § 103) to mix the Winter metallocene with an aluminoxane to make the "catalyst system" which Winter says is covered by Fujita claim 8. Likewise, if we presume that Fujita is prior art vis-a-vis Winter, then if one skilled in the art would have appreciated which metallocene is used to make the activated catalysts of Fujita claim 14. That metallocene anticipates (35 U.S.C. § 102) Winter claim 1.

If one presumes that the Spaleck metallocene is prior art vis-a-vis Fujita, then it manifestly would have been obvious (35 U.S.C. § 103) to mix the Spaleck metallocene with an aluminoxane to make the "catalyst system" which Spaleck says is covered by Fujita claim 8. Likewise, if we presume that Fujita is prior art vis-a-vis Spaleck, then if one skilled in the art would have appreciated [*39]which metallocene is used to make the activated catalysts of Fujita claim 15. That metallocene anticipates (35 U.S.C. § 102) Winter claim 1.

H.

Winter has failed to sustain its burden of demonstrating that there is no interference-in-fact between Winter and Fujita in Interference 104,283. Accordingly, Winter Preliminary Motion 1 is denied.

Spaleck has failed to sustain its burden of demonstrating that there is no interference-in-fact between Spaleck and Fujita in Interference 104,284. Accordingly, Spaleck Preliminary Motion 1 is denied.

Part II.

Winter and Spaleck request for benefit

A.

Winter and Spaleck, in their respective Preliminary Motion 2, request to be accorded the benefit for the purpose of priority of Patent 208. Fujita opposes their requests. Resolution of the issue of whether Winter and/or Spaleck should be accorded benefit turns on whether Patent 208 sufficiently describes the subject matter of the count of Interference 104,283 and/or the count of Interference 104,284.

B.

Winter and Spaleck can succeed if they can demonstrate that Patent 208 describes a species within the scope of the relevant count. *Hunt v. Treppschuh*, 523 F.2d 1386, 1389, 187 USPQ 426, 429 (CCPA 1975)[*40] (an application need only disclose a single enabled embodiment within the scope of the count to constitute a constructive reduction to practice of the invention of the count).
n17

n17 A rationale which supports the holding in *Hunt v. Treppschuh* is that if a party describes a single species within the scope of the count, the opposing party is not entitled to a patent covering subject which is not patentably distinct from the disclosed species.

We have found, however, that Patent 208 does not describe a species within the count of Interference 104,283 or the count of Interference 104,284. Accordingly, Winter and Spaleck are not entitled to be accorded benefit for the purpose of priority based on the principles of *Hunt v. Treppschuh*.

C.

The fact that Patent 208 does not describe a species within the scope of the count of Interference 104,283 or the count of Interference 104,284 is not fatal to the Winter and Spaleck effort to be accorded benefit of Patent 208. In other words, we would not foreclose a possibility that in an appropriate case a benefit application might contain a sufficient description of the subject matter of the count or a party's claims corresponding to the[*41] count to justify according benefit notwithstanding the absence of a description of a species within the scope of the count (Tr 76:20 to 77:5).

In Interference 104,283, the count requires that there be a substituent on the 5- and/or 6-position of each ring structure (i.e., the R<4> or R<5> of Winter and the methyl or phenyl of the R<2> of Fujita is attached to the 5-position of the indene ring). The question thus becomes whether Patent 208 contains a sufficient description of the requirement for a substituent in the 5-

and/or 6-position.

D.

Our appellate reviewing court made the following observation in *Eiselstein v. Frank*, 52 F.3d 1035, 1040, 34 USPQ2d 1467, 1470 (Fed. Cir. 1995) (citations omitted):

"Satisfaction of the description requirement insures that subject matter presented in the form of a claim subsequent to the filing date of the application was sufficiently disclosed at the time of filing so that the prima facie date of invention can fairly be held to be the filing date of the application." In order to determine whether a prior application meets the "written description" requirement with respect to later-filed claims, the [*42]prior application need not describe the claimed subject matter in exactly the same terms as used in the claims; it must simply indicate to persons skilled in the art that as of the earlier date the applicant had invented what is now claimed. The test is whether the disclosure of the application relied upon reasonably conveys to a person skilled in the art that the inventor had possession of the claimed subject matter at the time of the earlier filing date. "Precisely how close the original description must come to comply with the description requirement of § 112 must be determined on a case-by-case basis."

Our appellate reviewing court also observed in *Fujikawa v. Wattanasin*, 93 F.3d 1559, 1570-71, 39 USPQ2d 1895, 1904-05 (Fed. Cir. 1996) (citations omitted):

As the Board recognized, however, *ipsis verbis* disclosure is not necessary to satisfy the written description requirement of section 112. Instead, the disclosure need only reasonably convey to persons skilled in the art that the inventor had possession of the subject matter in question. In other words, the question is whether Wattanasin's "application provides adequate direction [*43]which reasonably [would lead] persons skilled in the art" to the sub-genus of the proposed count.

Many years ago our predecessor court graphically articulated this standard by analogizing a genus and its constituent species to a forest and its trees. As the court explained:

It is an old custom in the woods to mark trails by making blaze marks on the trees. It is no help in finding a trail . . . to be confronted simply by a large number of unmarked trees. Appellants are pointing to trees. We are looking for blaze marks which single out particular trees. We see none.

* * * *

Were we to extend Ruschig's metaphor to this case, we would say that it is easy to bypass a tree in the forest, even one that lies close to the trail, unless the point at which one must leave the trail to find the tree is well marked. Wattanasin's preferred embodiments do blaze a trail through the forest; one that runs close by Fujikawa's proposed tree. His application, however, does not direct one to the proposed tree in particular, and does not teach the point at which one should leave the trail to find it.

E.

We do not find the necessary blaze marks in Patent 208.

Patent 208 describes a genus which embraces[*44] compounds having substituents in the 5-, 5'-, 6- and 6'-positions. However, Patent 208 does not specifically describe any particular compound with a substituent in the 5- and/or 6-positions. Patent 208 says that the preferred metallocenes are those wherein R<10> is hydrogen (col. 3, line 67 through col. 4, line 13). All of the Patent 208 examples appear to describe metallocenes wherein all the R<10>s are hydrogen.

Winter and Spaleck acknowledge that the position of the substituent at the 5- and/or 6-position is not without significance. See Finding 81. Metallocenes with substituents at the 5- and 6-position, on this record, are patentably distinct from metallocenes with substituents at the 4-position. Otherwise, there would have been only one interference declared between Winter and Spaleck versus Fujita. The parties have treated the counts in the two interferences as patentably distinct. Both Winter (Findings 25-26) and Spaleck (Findings 32 and 38) emphasize the importance of the position where substituents are attached. Accordingly, Patent 208 does not contain the necessary description to accord Winter and Spaleck its benefit for the purpose of priority in these interference. [*45] Cf. *Bigham v. Godtfredsen*, 857 F.2d 1415, 1417-18, 8 USPQ2d 1266, 1268-69 (Fed. Cir. 1988).

Winter has failed to sustain its burden of demonstrating that it is entitled to be accorded the benefit for the purpose of priority of Patent 208 in Interference 104,283. Accordingly, Winter Preliminary Motion 2 is denied. Because Winter will not be accorded benefit and there will be no priority testimony, a judgment will be entered in favor of Fujita on the issue of priority.

Spaleck has failed to sustain its burden of demonstrating that it is entitled to be accorded the benefit for the purpose of priority of Patent 208 in Interference 104,284. Accordingly, Spaleck Preliminary Motion 2 is denied. Because Spaleck will not be accorded benefit and there will be no priority testimony, a judgment will be entered in favor of Fujita on the issue of priority.

III.

Preliminary motions to add reissue applications

A.

The rules authorize a patentee involved as a party in an interference to file a preliminary motion to add a reissue application to an interference. 37 CFR § 1.633(h). The preliminary motion must comply with the requirements of 37 [*46]CFR § 1.637(h). Rule 637(h) provides (emphasis added):

§ 1.637 Content of motions.

(h) A preliminary motion to add an application for reissue under § 1.633(h) shall:

- (1) Identify the application for reissue.
- (2) Certify that a complete copy of the file of the application for reissue has been served on all opponents.
- (3) Show the patentability of all claims in, or proposed to be added to, the application for reissue which correspond to each count and apply the terms of the claims to the disclosure of the application for reissue; n18 when necessary a moving applicant for reissue shall file with the motion an amendment adding any proposed claim to the application for reissue.
- (4) Be accompanied by a motion under § 1.633(f) requesting the benefit of the filing date of any earlier filed application, if benefit is desired.

n18 With respect to the meaning of the language "show the patentability of all claims * * * which correspond to * * * [the] count," see Notice of the Chief Administrative Patent Judge, "Interference Practice--Interference Rules Which Require a Party to "Show the Patentability" of a Claim," 1217 Off. Gaz. Pat. & Tm. Office 17 (Dec. 1, 1998).
[*47]

The parties disagree as to whether Winter and Spaleck have complied with Rule 637(h) (3). Specifically, Fujita maintains that Winter and Spaleck did not comply with Rule 637(h) (3). See Findings 94-95, 100-101 and 107.

There is no rule which authorizes the filing of a preliminary motion to add a claim to an "ordinary" application (as distinguished from a reissue application) and have the claim designated as not corresponding to the count. Likewise, there is no rule which authorizes the filing of a preliminary motion to add a claim to a reissue application and have the claim designated as not corresponding to the count. Hence, there is a long-standing practice of not permitting an applicant in an ordinary application to file a preliminary motion to add claims to its reissue application for the purpose of having those claims designated as not corresponding to the count. See, e.g., *L'Esperance v. Nishimoto*, 18 USPQ2d 1534, 1537 (Bd. Pat. App. & Int. 1991). The board's practice is currently implemented by (1) dismissing preliminary motions seeking to add claims and to have those claims designated as not corresponding to the count and[*48] (2) not "entering" any amendment submitted with the preliminary motion (37 CFR § 1.615(a)). The rationale which supports the policy of not permitting an applicant to add a claim and have the claim designated as not corresponding to a count applies with equal force to claims in a reissue sought to be added to the interference. n19 Moreover, there is no express provision in Rule 637(h) which permits a patentee to discuss any non-original patent claim which the patentee believes should be designated as not corresponding to the count. n20 The provision of Rule 637(h) (3) which states "when necessary a moving applicant for reissue shall file with the motion an amendment adding any proposed claim to the application for reissue" would be subject to the limitations of Rule 633(c) and Rule 637(c), neither of which permit a preliminary motion to add a claim to be designated as not corresponding to the count. In fact, Rule 637(h) (3) refers only to claims which correspond to the count. Hence, Rule 637(h) should be construed to not authorize the addition of reissue applications to an interference when the reissue application contains non-original patent claims which the reissue applicant[*49] does not seek to have designated as corresponding to the count. A reissue applicant should not be able through the back door to do what every other applicant cannot do through the front door.

n19 If a party could file a preliminary motion to have a claim, not previously considered by an examiner, designated as not corresponding to the count, then to grant the preliminary motion, the board in the first instance would have to determine that the claim is not directed to the same patentable invention as the count. The board would be in the business of rendering essentially advisory opinions which should not be binding on the examiner. The examiner may, and is more likely to, know of additional art, not considered by the board, which might establish that the claim is directed to the same patentable invention as the count.

n20 A patentee filing a reissue and asking that the reissue be added to the interference may have to mention an original patent claim because that original patent claim may have been designated as not corresponding to the count when the interference was initially declared.

For the reasons given, we agree with Fujita that the Winter and Spaleck preliminary[*50] motions to add reissue applications should be dismissed because both Winter and Spaleck seek to add reissue applications with claims which they do not feel should be designated as corresponding to the count. According, Winter Preliminary Motion 3 and Spaleck Preliminary Motion 3 are dismissed. n21 Since both preliminary motions are being dismissed, it is not necessary to reach, or express any views on the merits of, the issue of whether Winter 719 claims 7-12 and Spaleck 832 claims 5-10 cover subject matter which is the same patentable invention as the counts in the respective interferences. n22

n21 We recognize that Winter and Spaleck filed their respective reissue applications to claim priority. See *State of Israel v. Brenner*, 273 F.Supp. 714, 155 USPQ 486 (D.D.C. 1967), aff'd, 400 F.2d 789, 158 USPQ 584 (D.C. Cir. 1968) (reissue may be filed to perfect claim for foreign priority not perfected during prosecution of application which matured into patent sought to be reissued). The claim for priority was necessary to support their effort to obtain benefit of the 208 Patent. Since Winter and Spaleck failed on the merits (i.e., Winter and Spaleck Preliminary Motions 2 have been denied), they do not need their reissue in these interferences to perfect their claim for benefit. Had we ruled otherwise on the benefit issue, we would have granted the motion to add the reissue applications contingent on Winter and Spaleck promptly cancelling Winter 719 claims 7-12 and Spaleck 832 claims 5-10.

[*51]

n22 Nor do we feel that Winter and/or Spaleck necessarily had a full opportunity to develop on the merits the issue of whether Winter 719 claims 7-12 and Spaleck 832 claims 5-10 should correspond to the count. The question of who had the burden of proof in these interferences has never been clear and is contested by the parties. See Findings 110 and 111. If we had authority under the rules to reach the merits issue, we would be inclined to permit Winter and Spaleck to respond to Fujita's latest submission with cross-examination or

declarations of their own witnesses or both.

B.

In light of the discussion in Part III-A, *supra*, we today announce the following practice. In the future we will dismiss any preliminary motion under Rule 633(h) which seeks to add a reissue application to an interference when the reissue application contains non-original patent claims which the reissue applicant does not seek to have designated as corresponding to a count. Our newly announced practice does not preclude a patentee in an interference from filing a reissue application. If the reissue application contains new claims which the reissue applicant does not seek to have designated as[*52] corresponding to the count, the reissue application will not be added to the interference.

C.

After the interference is over, the Winter and Spaleck reissue applications will come before the examiner for ex parte examination. One issue the examiner will have to consider is whether Winter 719 claims 7-12 and Spaleck 832 claims 5-10 are patentable. In particular, the examiner may have to determine whether the claims should be rejected as being unpatentable over the lost count and/or on the basis of the rationale of *In re Deckler*, 977 F.2d 1449, 24 USPQ2d 1448 (Fed. Cir. 1992).

The arguments presented by Fujita and the declaration of Dr. Tobin Marks are material to the patentability within the meaning of 37 CFR § 1.56. Accordingly, we recommend that Winter and Spaleck supply copies to the examiner in the Winter and Spaleck reissue files of all arguments made by Fujita and all evidence supplied by Fujita, including the declaration of Dr. Marks. n23

n23 A third-party declaration is admissible in ex parte examination. *In re Reuter*, 670 F.2d 1015, 210 USPQ 249 (CCPA 1981) (third party affidavit admissible in ex parte PTO proceeding. We voice no opinion on the weight which should be given to Fujita's arguments and evidence with respect to the patentability of Winter 719 claims 7-12 and/or Spaleck 832 claims 5-10. [*53]

IV.

Fujita Rule 635 motion to strike

Fujita has moved to strike Winter Reply 1 and Spaleck Reply 1. Much of what Fujita has to say about new arguments in the Winter and Spaleck replies has merit. For example, Fujita correctly notes that the replies do not follow the format required in the NOTICE DECLARING INTERFERENCE. See P26(c)(4) at page 21. n24 Failure to follow the format renders it difficult to determine whether a reply raises new issues.

n24 We also note the following additional defects in the Winter and Spaleck replies. The replies presume the truth of statements made in the specification

of the Winter and Spaleck patents despite the fact that the patents are not admissible to prove the truth of statements made therein. See NOTICE DECLARING INTERFERENCE, P41. Copies of the Winter and Spaleck patents were not made exhibits. See NOTICE DECLARING INTERFERENCE, P37.

In our opinion, Winter Preliminary Motion 1 and/or Spaleck Preliminary Motion 1 do not make out a prima facie case that there is no interference-in-fact. Based on the content of the preliminary motions and the oral argument, we have little, if any, doubt that Winter or Spaleck failed to [*54] sustain their burden of establishing no interference-in-fact. Hence, it was generally unnecessary for us to consider either Fujita's oppositions or the Winter or Spaleck replies.

However, we would be less than candid if we did not acknowledge having read Fujita's oppositions. A cursory review of Winter Reply 1 and Spaleck Reply 1 will show that numerous new arguments were made by Winter and Spaleck in their replies.

We have found it unnecessary to consider the replies with one exception. Fujita in its oppositions and Winter and Spaleck in their replies have discussed the scope of, and the meaning of language in, Fujita claim 8. We have considered the Winter and Spaleck replies only to the extent that they take issue with Fujita's opposition with respect to the meaning of Fujita claim 8 and only to the extent that the replies rely on admissible evidence. n25 Otherwise, we have not found it necessary to consider Winter Reply 1 or Spaleck Reply 1.

n25 See n.12, supra.

We continue to be concerned with inappropriate replies being filed in interference cases. See Part 2-a. of Nau v. Ohuchida, n26 which states:

It has long been the perception of most, if not all, of [*55] the administrative patent judges of this board that counsel routinely raise new arguments and present new evidence with replies. Presentation of new arguments and evidence with replies raise several concerns which the Trial Section had hoped to eliminate through requirements in the NOTICE DECLARING INTERFERENCE.

One concern is whether a good faith effort was made in the first instance in filing a motion, including a preliminary motion. To this end, it is the practice of the Trial Section to consider a motion. If it finds that the motion fails to make out a prima facie case for relief, the motion may be denied without consideration of any opposition or reply. The Trial Section does not deem it fair to an opponent when a party "gets its licks in" for the first time at the reply stage after the opponent can no longer submit evidence and/or argument. In short, the Trial Section hopes to eliminate the unfair tactical advantage which can be gained through improper replies.

Another concern is that improper replies make the decision-making process difficult. It is time-consuming to read a motion only to discover that the issue to be resolved is joined at the reply stage. Hence, new arguments[*56] and new evidence at the reply stage generally result in inefficient administration

of justice inefficient, all contrary to the philosophy set out in 37 CFR § 1.601.

The Trial Section's concern with replies is not a new development. At the time the "new" interferences rules were being considered, it was proposed to allow replies only for certain motions. Notice of Proposed Rulemaking, Patent Interference Proceedings, 49 Fed. Reg. 3766, 3776 (col. 3), 3793 (col. 2) (Jan. 30, 1984). As a result of comments received following the notice of proposed rulemaking, it was decided to permit replies in all instances. However, the following observation can be found in the Notice of Final Rule (emphasis added):

Another comment made at the hearing suggested that a reply to an opposition to a motion should be permitted as a matter of course. Upon consideration of the comment, it has been decided to authorize the filing of replies to opposition to all motions. Presently, replies are permitted as a matter of course only for oppositions to motions under 37 CFR 1.231 [1984]. Section 1.638(b), as changed, would permit the reply in every instance. The PTO over the years has[*57] received complaints concerning the inability of a party to file replies. The change being made in § 1.638(b) will be reviewed sometime in the future to determine whether authorizing replies is helpful to the Board and/or whether undue delay in resolving interference occurs because replies are filed. Moreover, the PTO will make a judgment on whether "new issues" are being raised as a matter of course in replies. It can thus be seen that the change in authorizing replies may be considered experimental and could be changed in the future if found to be counter-productive or inconsistent with the objective of resolving interferences in a relatively prompt manner (emphasis added). Notice of Final Rule, Patent Interference Proceedings, 49 Fed. Reg. 48416, 48442 (col. 3) (Dec. 12, 1984). The Trial Section has gone out of its way to eliminate the raising of new arguments in replies. See Paragraph 31 of the NOTICE DECLARING INTERFERENCE. If the interference bars wishes to retain its option of being able to file replies, then it should make every effort to avoid raising improper new arguments and presenting improper new evidence with replies. Quite frankly, [*58] if the efforts of the Trial Section are not successful, we see the next step as a proposal to amend the rules to permit a reply only with leave of an administrative patent judge.

n26 <http://www.uspto.gov/web/offices/dcom/bpai/its/104258.pdf>.

The Trial Section feels that one more warning is in order to all concerned that we will strictly enforce the reply brief practice as of the date this opinion is published on the PTO Web Page or elsewhere. Whatever may have been the expectation prior to that publication, we feel we are left with little choice. Moreover, any reply which does not use the format required by P26(c), including P26(c)(4), of the NOTICE DECLARING INTERFERENCE will be returned. We take a final warning step in what we perceive to be the same spirit in which the Federal Circuit recently has taken steps to curb the raising of arguments before that court which are inconsistent with arguments made to a district court. See *Key Pharmaceuticals v. Hercon Laboratories Corp.*, 161 F.3d 709, 715-16, 48 USPQ2d 1911, 1916 (Fed. Cir. 1998) and *Hockerson-Halberstadt v. Converse Inc.*, 183 F.3d 1369, 1374 (Fed. Cir. 1999), [*59] which states:

As a preliminary matter, this court decides that HHI has not waived the claim construction it advances on appeal. The recent case of *Key Pharmaceuticals v. Hercon Laboratories Corp.*, 161 F.3d 709, 48 USPQ2d (BNA) 1911 (Fed. Cir. 1998) presented a similar issue. In *Key*, Hercon challenged on appeal the very claim construction it convinced the trial court to adopt. Finding Hercon's position "highly questionable," this court noted:

Ordinarily, doctrines of estoppel, waiver, invited error, or the like would prohibit a party from asserting as "error" a position that it had advocated at the trial.

Id. at 715. However, because this court had not issued an opinion publicly condemning this behavior and because *Key* did not object, the *Key* court exercised an "abundance of fairness" and revisited the claim construction issue. See *id.* at 715-16.

The parties completed briefing in the case at bar on November 19, 1998, about a week before this court's November 25, 1998 decision in *Key*. Thus, the present parties, as in *Key*, [*60] did not have the benefit of an opinion of this court noting the impropriety of switching claim constructions on appeal. Accordingly, this court again exercises an abundance of fairness and reviews the correctness of the district court's claim construction.

We deem it appropriate to exercise the same abundance of fairness in this case that the Federal Circuit exercised in *Key* and *Hockerson-Halberstadt*. We do not intend to be so charitable once this opinion appears on the PTO Web Page or is otherwise published.

For the reasons given, we exercise our discretion by declining to strike Winter Reply 1 and Spaleck Reply 1. Fujita's Rule 635 Motion to strike is denied.

V.

The Winter and Spaleck Rule 635 motions to leave to file belated preliminary motions

Winter and Spaleck seek to file belated preliminary motions to challenge the patentability of Fujita's claims under the first and second paragraphs of 35 U.S.C. § 112. Winter and Spaleck argue that there is good cause for not having earlier filed the preliminary motions. We disagree and therefore the Winter and Spaleck Rule 635 motions are denied.

Winter and Spaleck are said to [*61] have been surprised by a Fujita construction given Fujita claim 8 in a paper filed by Fujita on 25 May 1999 (283 Paper 50; 284 Paper 51). By virtue of being surprised, Winter and Spaleck say they could not have earlier filed a preliminary motion attacking the patentability of Fujita claim 8 under 35 U.S.C. § 112. But, it is absolutely plain on this record that as early as the filing of Winter Reply 1 and Spaleck Reply 1 on 17 May 1999 in response to Fujita oppositions filed 16 April 1999 that there was a disagreement as to the meaning of Fujita claim 8. Moreover, both the examiner (FEx 2004, page 3--"the instant [Fujita] claims read on compounds as well as the catalyst composition") and the NOTICE DECLARING INTERFERENCE, page 43 (Fujita claim 16--which depends from Fujita claim 8--is directed to a catalyst which is a compound) construed Fujita claim 8 as being

directed to a compound. It appears that Winter and Spaleck have never agreed with the examiner's construction of Fujita claim 8 or the construction placed on the Fujita claims in the NOTICE DECLARING INTERFERENCE.

The issues Winter and Spaleck seek to raise in a belated preliminary motion are[*62] manifestly afterthoughts which come too late in this interference.

VI.

Fujita Rule 635 motion 2 to file declaration

Fujita has moved to file and have considered on the merits a declaration of Dr. Tobin Marks. See Findings 56(11) and 113. Inasmuch as we have dismissed Winter Preliminary Motion 3 and Spaleck Preliminary Motion 3, as requested by Fujita, we do not reach the remaining grounds of Fujita for opposing the preliminary motions. Accordingly, there is no need to consider the Marks declaration. Fujita's Rule 635 Motion 2 is therefore dismissed.

VII.

Priority of invention

Fujita is entitled to an earlier benefit date. There will be no priority testimony since the parties rely on their filing dates in the respective preliminary statements. Accordingly, Fujita is entitled to a judgment on the issue of priority in its favor in both interferences.

A separate judgment will be entered in each interference.

Abbreviations used in opinion

283 Paper xx	Paper number of paper in the file of Interference 104,283, Winter v. Fujita
284 Paper xx	Paper number of paper in the file of Interference 104,284, Spaleck v. Fujita
FEx	Fujita exhibit
Fujita	The inventive entity named in application 08/678,686, filed 11 July 1996 which is involved in both Interference 104,283 and Interference 104,284
Patent 208	U.S. Patent 5,276,208, issued 4 January 1994
PTO	Patent and Trademark Office
SEx	Spaleck exhibit
Spaleck	The inventive entity named in U.S. Patent 5,329,033 which is involved in Interference 104,284
Spaleck 832	Spaleck application 09/253,832, filed 19 February 1999 seeking to reissue Spaleck U.S. Patent 5,329,033 which is involved in Interference 104,284
Tr x:y-z	Page x, lines y to z of the transcript of oral argument on 29 September 1999
WEx	Winter exhibit
Winter	The inventive entity named in U.S. Patent

1999 Pat. App. LEXIS 7, *62; 53 U.S.P.Q.2D (BNA) 1234

Winter 719

5,455,365 which is involved in Interference
104,283

Winter application 09/252,719, filed
19 February 1999 seeking to reissue Winter
U.S. Patent 5,455,365 which is involved in
Interference 104,283

[*63]

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